

No. 14399

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United States  
Court of Appeals  
for the Ninth Circuit

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D & H ELECTRIC COMPANY, a corporation,  
Appellant,

vs.

M. STEPHENS MFG., INC., a corporation and  
JACK McLOUGHLIN, doing business as Mc-  
Loughlin Sales, Appellees.

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Transcript of Record

In Two Volumes

VOLUME I.

(Pages 1 to 188, inclusive)

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Appeal from the United States District Court for the Southern  
District of California, Central Division

FILED

OCT 26 1954



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## INDEX

[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in *italic*; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in *italic* the two words between which the omission seems to occur.]

	PAGE
Answer and Counterclaim .....	9
Answer to Counterclaim .....	18
Appeal:	
Certificate of Clerk to Transcript of Record	
on .....	34
Cost Bond on .....	29
Designation of Record on (DC).....	32
Designation of Record on (USCA).....	187
Notice of .....	28
Order Extending Time to Docket.....	31
Statement of Points on (USCA).....	185
Stipulation and Order Extending Time to	
Docket .....	31
Certificate of Clerk to Transcript of Record...	34
Complaint .....	3
Cost Bond on Appeal.....	29
Designation of Record on Appeal (DC).....	32
Designation of Record on Appeal (USCA)....	187

## ii.

Findings of Fact and Conclusions of Law.....	19
Judgment, Final .....	27
Names and Addresses of Attorneys.....	1
Notice of Appeal .....	28
Opinion of the Court, Oral.....	167
Order Extending Time to Docket Appeal.....	31
Statement of Points on Appeal (USCA).....	185
Stipulation and Order Extending Time to Docket Appeal .....	31
Transcript of Court's Oral Opinion.....	167
Transcript of Proceedings and Testimony.....	35
Exhibits for Plaintiff:	
1—Patent in Suit No. 2,475,322.....	189
Admitted in Evidence .....	36
25—Drawing Prepared by R. S. Berry, “ $\frac{3}{8}$ in. DH and $\frac{3}{8}$ in. MS Couplings”..	192
Admitted in Evidence .....	104
26—Drawing Prepared by R. S. Berry, “ $\frac{1}{2}$ in. DH and $\frac{1}{2}$ in. MS Couplings”..	193
Admitted in Evidence .....	104
27—Drawing Prepared by R. S. Berry, “ $\frac{3}{4}$ in. DH and $\frac{3}{4}$ in. MS Couplings”..	194
Admitted in Evidence .....	104
28—Drawing Prepared by R. S. Berry, “1 in. DH and 1 in. MS Couplings”....	195
Admitted in Evidence .....	104

Transcript of Proceedings—(Continued)

Witnesses for Plaintiff:

Berry, R. S.

—direct .....	81
—cross .....	100
—recalled, direct .....	151

Friedman, Samuel W.

—direct .....	105
—cross .....	106
—recalled, direct .....	161

Horton, R. J.

—direct .....	37
—cross .....	55
—recalled, direct.....	74, 138, 166
—cross .....	78

Witness for Defendants:

Friedman, Samuel W.

—direct .....	110
—cross .....	121
—recalled, direct .....	124
—cross .....	131



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[1\*]

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\* Page numbers appearing at foot of page of original Transcript of Record.



In the United States District Court for the Southern District of California, Central Division

No. 14746-Y.—Civil

D & H ELECTRIC COMPANY, a corporation,  
Plaintiff,

vs.

M. STEPHENS MFG., INC., a corporation; JACK  
McLOUGHLIN, doing business as McLOUGHLIN  
SALES; DOE I, DOE II and DOE COMPANY,  
Defendants.

COMPLAINT FOR INFRINGEMENT OF U. S.  
LETTERS PATENT No. 2,475,322 AND FOR  
UNFAIR COMPETITION

Plaintiff complains of defendants and each of  
them and alleges:

First Cause of Action for Patent Infringement

I.

That plaintiff is a California corporation having  
its principal place of business in the County of Los  
Angeles, State of California, within the Southern  
District of California, Central Division.

Upon information and belief, that defendant M.  
Stephens Mfg., Inc., is a California corporation  
having a regular and established place of business  
in the City of Los Angeles, County of [2] Los An-  
geles, State of California, within the Southern Dis-  
trict of California, Central Division.

Upon information and belief, that Jack Mc-

Loughlin is an individual doing business as McLoughlin Sales, and is a resident of the County of Los Angeles, State of California, within the Southern District of California, Central Division.

## II.

That the true names and places of residence and places of business of defendants named herein as Doe I, Doe II and Doe Company are at present unknown to plaintiff, but, when discovered, plaintiff will ask leave of Court to insert the same herein by amendment.

## III.

That jurisdiction is based upon 28 U.S.C. 1338.

## IV.

That on July 5, 1949, United States Letters Patent 2,475,322 duly and legally issued to Richard J. Horton and Helen F. Bryane, now Helen F. Horton, for an invention in coupling device for flexible conduits.

## V.

That by mesne assignment and transfer, said letters patent and all rights to sue and recover for past infringement thereof were duly and legally transferred to plaintiff prior to commencement of this action and plaintiff is still the owner thereof.

## VI.

That for some time past defendants and each of them have infringed and still are infringing said United States Letters Patent 2,475,322, by making



and selling within the Southern [3] District of California, Central Division, and elsewhere, coupling devices for flexible conduits embodying the patented invention, and will continue to do so unless enjoined by this Court.

## VII.

That the coupling devices for flexible conduits made and sold by plaintiff or under authority of plaintiff have been duly marked with the number of said letters patent and defendants have been notified in writing of said letters patent and of their infringement thereof.

## VIII.

That said acts of defendants have been and are being committed wilfully and in bad faith.

### Second Cause of Action for Unfair Competition

For a second and separate cause of action against the defendants and each of them plaintiff here incorporates paragraphs one (I) and two (II) of its first cause of action and alleges:

## I.

That, commencing in or about the month of May, 1946, plaintiff developed and introduced to the trade a coupling device for flexible conduits, for which said United States Letters Patent No. 2,475,322 subsequently issued; that said coupling device is distinctive not only in the manner in which it functions to effect a coupling, but also in appearance; that plaintiff has ever since manufactured

and sold and continues to manufacture and sell said devices extensively in interstate commerce throughout the United States; has built up and owns and enjoys a valuable business and good will associated therewith; and the public has come to associate said device with plaintiff and no one else. [4]

## II.

Jurisdiction of this second cause of action arises under and by virtue of 28 U.S.C.A. 1338(b) and 15 U.S.C.A. 1126.

## III.

That after plaintiff developed and introduced said device and built up said business and good will, defendants engaged in and continue to engage in a scheme of unfair competition against plaintiff, and in carrying out said scheme have committed and continue to commit each and all of the following acts:

(a) Defendants copied and imitated said coupling device, both as to its distinctive manner of functioning and as to its distinctive appearance; and have made and sold and continue to make and sell said copies and imitations in interstate commerce in competition with plaintiff and without so marking or identifying said copies and imitations as to enable the public readily to distinguish the same from those made and sold by plaintiff;

(b) Defendants offered and attempted to purchase and acquire plaintiff's said business, as well as plaintiff's dies and molds used in the manufacture of plaintiff's said devices; that plaintiff re-

fused said offer and attempt and thereupon defendants attempted to coerce plaintiff into selling and turning over to defendants plaintiff's said business, dies and molds by making and publishing threats to plaintiff and to the trade that defendants would destroy plaintiff's said business and good will; and, ~~in pursuance of said attempt, defendants have adopted and pursued the policy of having their salesmen and representatives follow plaintiff's salesmen in the market and offer to sell said copies and imitations to the trade at prices far below the prices at which plaintiff has offered its said devices and at prices which could not be met by plaintiff without actual loss to plaintiff; and~~ [L. P. Y.]

(c) Defendants have represented to the trade and to plaintiff's customers that plaintiff's said patent is worthless.

#### IV.

That as a result of said acts of defendants, plaintiff has suffered loss of profits which it otherwise would have made as well as injury to its business and good will, in the sum of One Hundred Thousand Dollars (\$100,000.00), and defendants have derived unjust profits in a sum the true amount of which is at present unknown to plaintiff and which can only be determined by an accounting.

#### V.

That unless said acts of defendants be forthwith restrained by this Court, plaintiff will be further seriously and irreparably damaged in that plain-

tiff's business and good will will be totally destroyed.

## VI.

That said acts of defendants have been deliberate, wanton and unconscionable.

Wherefore, plaintiff prays judgment against defendants and each of them as follows:

1. For a temporary and permanent injunction restraining defendants and each of them, as well as those controlled by them and each of them, from committing further acts of infringement of said United States Patent No. 2,475,322.

2. For an accounting of damages suffered by plaintiff as a result of said acts of infringement, and that said damages be trebled. [6]

3. For a temporary and permanent injunction restraining defendants and each of them, as well as those controlled by them and each of them, from committing any of the herein-alleged acts of unfair competition against plaintiff.

4. For damages in the sum of One Hundred Thousand Dollars (\$100,000.00) resulting from acts of unfair competition by defendants and each of them herein complained of.

5. For an accounting of and judgment for profits derived by defendants and each of them from the acts of unfair competition herein complained of.

6. For reasonable attorneys' fees.

7. For plaintiff's costs and disbursements herein.

8. For such other and further relief as to the Court may appear just and equitable.

D & H ELECTRIC COMPANY,  
Plaintiff

By MASON & GRAHAM,  
/s/ By COLLINS MASON,  
Attorneys for Plaintiff [7]

[Endorsed]: Filed November 17, 1952.

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[Title of District Court and Cause.]

### ANSWER

Come now the defendants and in answer to the alleged First Cause of Action in the Complaint filed herein by the plaintiff, admit, deny and allege as follows:

#### I.

Admit, in answer to paragraph IV, that purported United States Letters Patent No. 2,475,322 are dated July 5, 1949 and were issued in the name of Richard J. Horton and Helen F. Bryane, [8] and that an alleged coupling device for flexible conduits is purported to be covered therein: deny that such patent was duly and legally issued to Richard J. Horton and Helen F. Bryane, or that said coupling device constitutes an invention.

#### II.

As to the averments in paragraph V, defendants

are without knowledge or information sufficient to form a belief as to the truth thereof.

### III.

Deny each and every allegation of paragraph VI.

### IV.

Admits that written notice from plaintiff was received by defendants alleging infringement of said Letters Patent, but deny each and every other allegation contained in paragraph VII.

### V.

Deny each and every allegation of paragraph VIII.

In Answer to the Alleged Second Cause of Action of the Complaint, said Defendants Admit, Deny and alleges as follows:

### VI.

Deny that said coupling device is distinctive in the manner in which it functions or distinctive in appearance, and deny that the public has come to associate said device with plaintiff and no one else.

As to the other averments of paragraph I, defendants are without knowledge or information sufficient to form a belief as to the truth thereof. [9]

### VII.

Deny each and every allegation of paragraph III (including sub-paragraphs (a), (b) and (c) thereof).

## VIII.

Deny each and every allegation of paragraphs IV and V, and particularly deny that defendants have engaged in acts of unfair competition against plaintiff.

## IX.

Deny each and every allegation of paragraph VI.

Further Answering the Complaint, and for Separate, Alternate and Further Defenses, the said Defendants allege:

## X.

Deny that the device shown, described and claimed in the Letters Patent in suit embodies any material or patentable advance over what was previously known to others skilled in the art; but, on the contrary, allege that the claim of said patent is invalid and void because the alleged improvements described and claimed therein, and all material and substantial parts thereof, have been, prior to the date of the alleged invention or discovery thereof by Richard J. Horton and Helen F. Bryane (now Helen F. Horton), described, published, patented or contained in Letters Patent and/or printed publications, as follows:

Number	Inventor	Date
1,494,524	Adamson	May 20, 1924
1,629,058	Wilson	May 17, 1927
1,775,128	Hunter	Sept. 9, 1930
1,830,250	Tiefenbacher	Nov. 3, 1931
1,973,170	Jacobi	Sept. 11, 1934
22,310	Great Britain	1910



Offered for sale by the General Electric Supply Corporation, 700 Turner Street, Los Angeles, California, more than one (1) year prior to the filing date of the patent in suit, and in other patents and publications of which the said defendants have not now sufficient identifying data, but which, when ascertained, the said defendants pray leave to add hereto by suitable amendment.

### XI.

That Richard J. Horton and Helen F. Bryane were not the original and first inventors of the alleged invention purported to be covered by the Letters Patent in suit, or of any material or substantial part thereof, and that the same and every material and substantial part thereof was described and disclosed, prior to the alleged invention thereof, in printed publications, among others, in the specifications and drawings of the Letters Patent listed in paragraph X above, and in other publications of which the said defendants have not now sufficient identifying data, but which, when ascertained, the said defendants pray leave to add hereto by suitable amendment.

### XII.

Allege that Patent No. 2,475,322 in suit is void and of no effect in law, in that devices containing the alleged improvements were known and in public use in the United States before the conception of, and/or before the reduction to practice by Richard J. Horton and Helen F. Bryane of, the alleged invention of the patent in suit, No. 2,475,322, by the



patentees named in said patents, whose places of knowledge, sale and/or use are the residences of the patentees given in said patents; and that said [11] alleged improvements were known, on sale and/or in public use in the United States for more than one (1) year prior to the application for United States Patent No. 2,475,322 by plaintiff and by Richard J. Horton and Helen F. Bryane in Los Angeles, California, and other places in the United States of America, and by the patentees named in said patents, whose places of sale and/or use are the residences of the patentees in said patents, respectively.

### XIII.

Allege that while the application for the patent in suit was pending in the United States Patent Office, plaintiff's assignors, Richard J. Horton and Helen F. Bryane, through their attorney, so limited and confined the claims of the application therefor, under the requirements of the Commissioner of Patents, that the plaintiff herein cannot now seek or obtain an interpretation of the claim thereof sufficiently broad to cover any device made, used or sold by the said defendants.

### XIV.

Allege that the art in connection with the device shown in said Letters Patent in suit was crowded prior to the alleged invention or discovery by Richard J. Horton and Helen F. Bryane; and that the conception of the alleged invention or discovery in said patent required no invention whatever, but

only ordinary mechanical skill; and that as a consequence the claim in suit fails to embody or disclose any patentable invention which was not already common knowledge in the art; and that such claim, therefore, is void for lack of invention.

### XV.

Allege that the patent in suit is invalid and void [12] since the subject matter covered by the claim thereof was not originated by Richard J. Horton and Helen F. Bryane, but was disclosed to them, in whole or in part, by one or more other parties, including O. K. Jones, of 2700 San Marino Street, Los Angeles, California, and, therefore, the alleged invention in the patent in suit could never belong to plaintiff's assignors, Richard J. Horton and Helen F. Bryane, or to plaintiff.

### XVI.

Allege that the claim of the patent in suit cannot be interpreted to cover any device made, used or sold by said defendants, for the reason that all said devices are constructed in accordance with patents and devices within the public knowledge prior to the alleged conception of the patent in suit by Richard J. Horton and Helen F. Bryane, and that, if the claim of said patent were so construed as to cover defendants' devices, it would be invalid as anticipated by the said prior patents and devices.

### XVII.

Allege that the claim in suit does not cover any

valid or patentable combination, but embraces mere aggregations of elements which have no definite and proper combination or cooperation, and that, therefore, the claim in suit fails to cover patentable subject matter, and is, therefore, void; and that the claim in suit is invalid because of not being supported by the disclosure in the application for patent thereon.

### XVIII.

Allege that the claim in suit is ambiguous, indefinite and uncertain, and is not distinct, and does not particularly point out the part, improvement or combination which [13] Richard J. Horton and Helen F. Bryane claimed as their alleged invention, as required by the Patent Statutes of the United States; and that the elements of the claim were all known prior to said alleged invention and result in no new and unexpected result.

### XIX.

Allege that plaintiff has not marked its connectors made in accordance with Patent No. 2,475,322, with the said patent number, as required by the Patent Statutes of the United States, but instead has placed upon a large number of its said connectors the legend, "Pat. 668,790". That plaintiff does not now and never has owned Patent No. 668,790, or any part thereof, or any rights thereunder. That said connectors marked with such legend were sold by plaintiff in the United States prior to the commencement of this action.

Allege that plaintiff, because of such mismarking

as herein set forth, comes into Court with unclean hands and is estopped from enforcing any alleged claim of infringement contained in the Complaint herein.

As a Counterclaim of Defendants in this case, Defendants allege:

## XX.

That plaintiff has engaged in acts of unfair competition against defendants, which have damaged the business and good will of defendants, by informing defendants' customers, distributors and suppliers that the connectors manufactured and sold by defendants infringe plaintiff's patent, when such is not the case, and by misrepresenting to plaintiff's customers that plaintiff had a suit or suits pending against one or more of the distributors of defendants' connectors, and by failing to inform [14] defendants that plaintiff considered that defendants' connectors infringed on Patent No. 2,475,332 until long after plaintiff had made said misstatements and misrepresentations, as aforesaid.

## XXI.

That as result of said acts of plaintiff, defendants have suffered loss of profits which they otherwise would have made, as well as injury to their business and good will, in the sum of \$25,000.00, and that plaintiff threatens to continue making the charges of infringement as aforesaid, unless restrained by this Honorable Court. That defendants have no plain, speedy or adequate remedy at law.

Wherefore, defendants pray judgment against plaintiff decreeing as follows:

(1) That the Letters Patent in suit be declared invalid and void;

(2) That the defendants have not infringed said Letters Patent;

(3) For temporary and permanent injunctions restraining plaintiff, its agents, employees, officers and directors, and those acting in concert with plaintiff, from committing again any of the herein-alleged acts of unfair competition against the defendants;

(4) For damages in the sum of \$25,000.00 resulting from acts of unfair competition by plaintiff herein complained of;

(5) That defendants be awarded their [15] costs and reasonable attorney fees in this case;

(6) For such other, further and different relief as in equity and good conscience this Honorable Court may deem advisable in the premises.

C. G. STRATTON and  
R. E. GEAUQUE,  
Attorneys for Defendants

/s/ By C. G. STRATTON [16]

Affidavit of Service by Mail attached. [17]

[Endorsed]: Filed May 28, 1953.

[Title of District Court and Cause.]

## ANSWER TO COUNTERCLAIM

Comes Now the plaintiff-counter-defendant D & H Electric Company, a corporation, and for answer to defendants' counterclaim, deny, admit and allege as follows:

### I.

Answering the allegations contained in paragraph XX thereof, deny the same save and except that it admits that it has informed some members of the trade that connectors made and sold by defendants-counterclaimants appear to infringe upon United States Letters Patent No. 2,475,322 and that it, plaintiff, has instituted suit therefor against the defendants herein named. Other than as herein specifically admitted, deny generally and specifically each and all of the allegations contained in said paragraph. [18]

### II.

Answering the allegations contained in paragraph XXI, deny each and all of said allegations. Further answering the allegations contained in said paragraph, deny that as a result of any act of the plaintiff, defendants have suffered loss of profits which they otherwise would have made or injury to their business or good will in the sum of \$25,000.00 or in any sum.

D & H ELECTRIC COMPANY, a  
corporation,  
Plaintiff-counter-defendant

By MASON & GRAHAM,  
/s/ By COLLINS MASON,  
Its Attorneys [19]

Affidavit of Service by Mail attached. [20]

[Endorsed]: Filed June 1, 1953.

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[Title of District Court and Cause.]

## FINDINGS OF FACT AND CONCLUSIONS OF LAW

This cause having come on for trial on January 5th and 6th, 1954, and the Court having heard the testimony, and having considered the oral arguments of counsel, makes the following Findings of Fact and Conclusions of Law: [21]

### Findings of Fact

#### I.

That the plaintiff and defendant corporation are California corporations having regular and established places of business in the City of Los Angeles, County of Los Angeles, State of California. That the defendant Jack McLoughlin is an individual doing business as McLoughlin Sales, and is a resident of the County of Los Angeles, State of California.

#### II.

That the patent in suit, United States Letters Patent No. 2,475,322, on Coupling Device for Flexible Conduits, was issued on July 5, 1949 to Richard



J. Horton and Helen F. Bryane. That by mesne assignment said Letters Patent and all rights to sue and recover for past infringement thereon were duly and legally transferred to the plaintiff herein prior to the commencement of this action, and plaintiff ever since has been and now is the owner thereof.

### III.

That no evidence was offered by plaintiff as to the date of the alleged invention of the subject matter of said Letters Patent in suit. Such alleged invention is, therefore, considered as being made on May 10, 1946, the date upon which the application for the patent in suit was filed in the United States Patent Office.

### IV.

That the patent in suit contains only one claim, as follows:

“In a coupling for spirally wound, flexible [22] conduits, a tubular member having means at one end adapted to be affixed to the wall of a junction box or the like, the other end of said coupling being insertable within the end of a conduit and having a series of ribs extending substantially at right angles to the major axis of said tubular member and adapted to engage the convolutions of the conduit, said ribs being sequentially disposed in staggered relation along the outer surface of the conduit-engaging portion of said coupling, so as to define a spiral having a greater helical angle than the normal helical angle of the convolutions of the conduit.”



## V.

That the device covered by the patent in suit is a simple one. It covers a combination of elements in a tubular member that has (a) a series of ribs extending substantially at right angles to its major axis, and (b) said ribs defining a spiral having a greater helical angle than the normal helical angle of the convolutions of the conduit. This combination is not found to be anticipated by the prior art cited by the defendants.

## VI.

That the file wrapper shows that the original application for the patent in suit claimed great originality for the plaintiff's coupling, and contained nineteen claims, covering seven typewritten pages. Eventually, these were reduced to two claims, to wit, claims 2 and 10, the claim finally allowed, as quoted above, being originally claim 2. The patentees urged that since claim 10 defined a spiral having a greater helical [23] angle than the normal helical angle of the convolutions of the conduit [which is element (b) above of the patent in suit], claim 10 was patentable. The Patent Office Examiner, however, rejected this argument and in rejecting claim 10 said it was "FINAL", in capital letters. The reason given by the Examiner was that the prior patent to Hunter, of record, showed the full equivalent of this, because any difference that existed "between the differential helical angle is deemed to be no more than a mere matter of choice, design or expediency." Confronted with this ob-

jection, the patentees canceled and relinquished claim 10.

## VII.

That the patentees of the patent in suit were required to elect which of the different forms of the invention would be elected, if a generic claim covering the different forms were not allowed. The patentees thereupon elected to prosecute claims drawn to Fig. 2 in the event no generic claims were allowed. No generic claim was ever allowed in the case. Fig. 2 shows the ribs 3, 4, 5 and 6 at right angles to the major axis of the tubular member 1.

## VIII.

That the Patent Office rejected claims covering the ribs shown at 3, 4, 5 and 6 in the patent in suit, upon the mutilated threads shown in the following prior United States Letters Patent: Adamson 1,494,524, Wilson 1,629,058, Jacobi 1,973,170, and upon British patent No. 22,310. That except for the right angular arrangement of said ribs to [24] the major axis of the coupling, the patentees of the patent in suit acquiesced in said rejection. That this Court holds that except for such right angular arrangement, said ribs perform the same function as the mutilated threads of said prior patents, and except for said right angular arrangement, said ribs are anticipated by the mutilated threads of said prior patents. In endeavoring to obtain the allowance of the claim in suit, the patentees argued that it was one of the important things in their invention that their ribs were at right angles, whereas

interrupted screw threads, such as the foregoing prior patents showed, are not "at right angles to the axis of the coupling." Later on in the same letter, patentees argued again that their ribs were novel because they extend "at right angles to the axis of the sleeve." In the same letter to the Examiner, the patentees amended the claim in suit to state that their ribs were "substantially at right angles to the major axis of said tubular member." Since the foregoing two arguments that an important difference in patentees' structure over the prior art was that the patent in suit showed the ribs at right angles, were in the same letter as the above amendment that the ribs are at "substantially right angles," these arguments must be considered as giving the patentees' interpretation of the only novel feature of the patent in suit, to wit, having the ribs at right angles. Having been refused broader claims in the Patent Office, and the patentees having conceded that the right angular position of their ribs was the patentable feature of their claim, they cannot now disregard this feature and attempt to recapture their broad claims which were canceled.

## IX.

That the operation of patentees' structure is that since their ribs form an angle of substantially 90° to the longitudinal axis of the coupling, there is a lengthwise stretching [25] action upon the conduit when it is screwed upon the patentees' coupling. On the other hand, the outside diameter of defendants' coupling is greater than the inside diameter

of the normal conduit, causing a lateral extending action by the ribs upon the interior of the conduit convolutions. This is shown by markings upon plaintiff's and defendants' respective couplings after they have been screwed into and then screwed out of normal conduits. Therefore, defendants' coupling operates and functions in a mode or manner different from plaintiff's.

### X.

That the function of the plaintiff's and defendants' couplings is to fasten the conduit on to the coupling. This is old, as demonstrated on the witness stand by plaintiff's president. An exemplification of the Hunter patent cited by the defendant, viz., the prior "Jake" connector, showed that tools were required to remove it from a conduit, the same as plaintiff's and defendants' devices. Thus, since the result is old, no infringement can be predicated upon the similarity between plaintiff's and defendants' couplings on the ground that they both fasten conduits upon the couplings so that tools are required to release the conduits.

### XI.

That the defendants made a few experimental, sample couplings along the line claimed in the patent in suit, and gave out one coupling each to a limited number of persons. The uncontradicted evidence is that they were not for sale and were never sold. This being a Court of Equity, no injunction is believed warranted since no likelihood exists of the

defendants commercially manufacturing or selling the patented device.

## XII.

That the word "substantially" is not to be interpreted as meaning one or more degrees. The words "substantially at [26] right angles" are only to be taken to mean at right angles with the slight variation that would occur in manufacturing plaintiff's couplings by ordinary production methods without precision finishing same. Under the authority of *Schnitzer vs. California Corrugated Culvert Co.*, 140 F.2d 275 (C.A. 9), the proceedings in the Patent Office may be used to interpret the wording of a claim, and where the file wrapper contains evidence that the inventors understood a certain element of a claim in a narrow sense, then the courts should apply that narrow interpretation in an infringement suit. The twice-given argument in the file wrapper that plaintiff's ribs were at right angles and for this reason differed from the prior art must be taken as limiting the patent in suit to ribs at right angles with only such variations in manufacture which in ordinary, non-precision manufacturing methods would result when endeavoring to have the ribs at right angles. The dotted lines in Fig. 2 of the patent in suit indicate that the ribs 3, 4, 5 and 6 are at right angles to the major axis, which is the Figure elected to be prosecuted in this patent.

## XIII.

That the defendants' couplings have ribs that are at a 2° to 6° angle to the longitudinal axis of the

coupling. Different sizes of couplings have the ribs at different angles. Thus the defendants' commercial couplings do not have ribs substantially at right angles to the major axis of the couplings.

### Conclusions of Law

#### I.

The Court has jurisdiction of the parties and of the subject matter.

#### II.

The patent in suit, No. 2,475,322, issued July 5, 1949 on Coupling Device for Flexible Conduits, is good and valid in law. [27]

#### III.

That the defendants herein have not infringed upon the patent in suit, since the defendants' couplings do not have ribs substantially at right angles to the major axis of the coupling, and since the defendants' couplings have a different mode of operation, to wit, binding a conduit upon the coupling by lateral expansion of the coupling, whereas the device of the patent in suit binds a conduit upon its coupling by lengthwise extension of the conduit.

#### IV.

That no basis exists for entering an injunction in this case.

#### V.

That neither party is to be awarded costs or attorneys' fees.

Judgment will be entered accordingly.

Dated this 9th day of March, 1954.

/s/ LEON R. YANKWICH,

Chief Judge, United States District  
Court [28]

Acknowledgment of Service attached. [29]

[Endorsed]: Filed March 9, 1954.

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In the United States District Court of the South-  
ern District of California, Central Division

No. 14,746-Y.

D & H ELECTRIC COMPANY, a corporation,  
Plaintiff,

vs.

M. STEPHENS MFG., INC., a corporation; JACK  
McLOUGHLIN, doing business as McLOUGH-  
LIN SALES; DOE I; et al.,  
Defendants.

### JUDGMENT

This cause having come on for trial on January 5th and 6th, 1954, and the Court having heard the testimony and having considered the oral arguments of counsel, enters the following judgment:

#### I.

That United States Letters Patent No. 2,475,322,



issued July 5, 1949, on Coupling Device for Flexible Conduits, is good and valid in law. [30]

## II.

That said Letters Patent has not been infringed by defendants, or either of them.

## III.

That no injunction shall be entered in this case.

## IV.

That neither party will recover costs or attorneys' fees from the other party.

Dated this 29th day of February, 1954.

/s/ LEON R. YANKWICH,

Chief Judge, United States District  
Court [31]

Acknowledgment of Service attached. [32]

[Endorsed]: Judgment entered and filed March 9, 1954.

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[Title of District Court and Cause.]

## NOTICE OF APPEAL

Notice Is Hereby Given that D & H Electric Company, a corporation, plaintiff in the above entitled action, hereby appeals to the Court of Appeals for the Ninth Circuit, from that portion of the final judgment entered herein on the 9th day of March, 1954, holding that the United States Letters



Patent in suit No. 2,475,322 has not been infringed by defendants or either of them and that no injunction shall be entered.

Dated at Los Angeles, California, this 6th day of April, 1954.

MASON & GRAHAM,  
/s/ By COLLINS MASON,  
Attorneys for Plaintiff [33]

[Endorsed]: Filed April 8, 1954.

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[Title of District Court and Cause.]

### COST BOND ON APPEAL

Know All Men By These Presents:

That we, D & H Electric Company, a corporation, as Principal, and The Travelers Indemnity Company, a corporation organized and existing under the laws of the State of Connecticut, and authorized to carry on the business of Surety in the State of California, as Surety, are held and firmly bound unto M. Stephens Mfg. Inc., a corporation, Jack McLoughlin doing business as McLoughlin Sales, Doe I, Doe II and Doe Company, in the full and just sum of Two Hundred Fifty and No/100 Dollars (\$250.00), to be paid to the said Appellees, their heirs and assigns, to which payment well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally by these presents.

Sealed with our seals this 5th day of April, 1954.

Whereas, on March 9, 1954, judgment was entered

in the District Court of the United States, Southern District of California, Central Division, in the above entitled case against the Appellant, and the Appellant has filed notice of appeal to the United States Court of Appeals for the Ninth District, in the State of California.

Now, Therefore, the condition of the above obligation is such that if the said Appellant shall prosecute his appeal to effect, and answer all costs if the appeal is dismissed or the judgment affirmed, or such costs as the Appellate Court may award if the judgment is modified, then the above obligation to be void, otherwise to remain in full force and virtue.

[Seal]            D & H ELECTRIC COMPANY,  
                         a corporation,

[Seal]            THE TRAVELERS INDEMNITY  
                         COMPANY,

/s/ By W. C. PHILLIPS, Attorney-in-Fact  
Examined and recommended for approval as per  
Rule 8.

/s/ COLLINS MASON,  
                         Attorney for Plaintiff

I hereby approve the foregoing bond. Dated the  
8th day of April, 1954.

/s/ By EDMUND L. SMITH, Clerk

The premium charge for this bond is \$10.00 per  
annum.

Notary Public Certificate attached.

[34]

[Endorsed]: Filed April 8, 1954.

[Title of District Court and Cause.]

ORDER EXTENDING TIME TO DOCKET  
APPEAL

Counsel for plaintiff having requested an order extending the time within which plaintiff may docket the appeal herein, and having represented to the Court as his reasons for said request, that the reporter has not yet been able to prepare the reporter's transcript of the trial proceedings, and that Mr. C. G. Stratton, attorney for defendants, is absent from the city,

It Is Hereby Ordered that the time within which plaintiff may docket the appeal herein is hereby extended to and including the 7th day of June, 1954.

Dated at Los Angeles, California, this 7th day of May, 1954.

/s/ LEON R. YANKWICH,

United States District Judge [35]

[Endorsed]: Filed May 7, 1954.

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[Title of District Court and Cause.]

STIPULATION AND ORDER EXTENDING  
TIME TO DOCKET APPEAL

It Is Hereby Stipulated by and between the parties to this action, through their respect attorneys, that plaintiff appellant may have to and in-

cluding the 22nd day of June, 1954, within which to docket the appeal herein, which time now expires on June 7, 1954.

This stipulation is rendered necessary because of unavoidable delay in obtaining the reporter's transcript. [40]

Dated at Los Angeles, California, this 28th day of May, 1954.

C. G. STRATTON,  
LOUIS M. WELSH,

/s/ By LOUIS M. WELSH,  
Attorneys for Defendants-Appellees

MASON & GRAHAM,

/s/ By COLLINS MASON,  
Attorneys for Plaintiff-Appellant

It Is So Ordered. Dated June 3, 1954.

/s/ BEN HARRISON,  
United States District Judge [41]

[Endorsed]: Filed June 3, 1954.

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[Title of District Court and Cause.]

### DESIGNATION OF RECORD

The Clerk of this Court is hereby requested to transmit to the United States Court of Appeals for the Ninth Circuit, under his hand and the seal of this Court, the following portions of the record, proceedings, and evidence to be contained in the record on appeal herein:

1. Complaint, filed November 17, 1952;
2. Answer and Counterclaim, filed May 28, 1953;
3. Answer to Counterclaim, filed June 1, 1953;
4. Reporter's transcript, January 5 and January 6, 1954, pages 1 to 180, inclusive;
5. Reporter's transcript of proceedings on January 6, 1954, containing opinion delivered orally by the Court, pages 1 [42] to 21 inclusive;
6. Plaintiff's exhibits 1 to 34 inclusive.
7. Defendants' exhibits A to D inclusive;
8. Findings of Fact and Conclusions of Law, filed March 9, 1954;
9. Final Judgment entered March 9, 1954, filed March 9, 1954;
10. Notice of Appeal;
11. Cost Bond on Appeal;
12. Order Extending Time to Docket Appeal;
13. Concise Statement of Points on Appeal;
14. Stipulation and Order Extending Time to Docket Appeal;
15. This Designation.

Dated at Los Angeles, California, this 3rd day of June, 1954.

MASON & GRAHAM,

/s/ By COLLINS MASON,

Attorneys for Plaintiff-

Appellant

[43]

Affidavit of Service by Mail attached.

[44]

[Endorsed]: Filed June 4, 1954.

[Title of District Court and Cause.]

CERTIFICATE OF CLERK

I, Edmund L. Smith, Clerk of the United States District Court for the Southern District of California, do hereby certify that the foregoing pages numbered 1 to 44, inclusive, contain the original Complaint; Answer and Counterclaim; Answer to Counterclaim; Findings of Fact and Conclusions of Law; Final Judgment; Notice of Appeal; Cost Bond on Appeal; Two Orders Extending Time to Docket Appeal; Statement of Points on Appeal and Designation of Record on Appeal which, together with the Original Exhibits and Reporter's Transcript of Proceedings on January 5 and 6, 1954, in three volumes, transmitted herewith, constitute the transcript of record on appeal to the United States Court of Appeals for the Ninth Circuit.

I further certify that my fees for preparing and certifying the foregoing record amount to \$2.00 which sum has been paid to me by appellant.

Witness my hand and the seal of said District Court this 18th day of June, A.D. 1954.

[Seal]

EDMUND L. SMITH,  
Clerk

/s/ By THEODORE HOCKE,  
Chief Deputy

In the United States District Court for the Southern District of California, Central Division

No. 14,746-Y.—Civil

D & H ELECTRIC COMPANY, a corporation,  
Plaintiff,

vs.

M. STEPHENS MFG., INC., a corporation: et al.,  
Defendants.

### TRANSCRIPT OF PROCEEDINGS

Los Angeles, Calif., Tuesday, Jan. 5, 1954, 10 a.m.

Honorable Leon R. Yankwich, Judge Presiding.

Appearances: For the Plaintiff: Mason & Graham, by Collins Mason, Esq., 811 West 7th St., Los Angeles 17, Calif. For the Defendants: C. G. Stratton, Esq., and Louis M. Welsh, Esq., 210 West 7th St., Los Angeles 14, Calif. [1\*]

The Court: Call the calendar.

The Clerk: No. 14,746-Y, D & H Electric Company vs. M. Stephens Mfg, Inc.; Mr. Mason, Mr. Stratton and Mr. Welsh appearing.

Shall I call the next case, your Honor?

The Court: Well, are you answering "Ready"?

Mr. Mason: The plaintiff is ready, your Honor.

Mr. Stratton: Yes.

The Court: All right.

(The court hears another matter.)

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\* Page numbers appearing at top of page of original Reporter's Transcript of Record.



The Court: All right, gentlemen, we will proceed with the cause on trial.

Mr. Stratton: If the court please, I would like to associate on the record for the defendant Mr. Louis M. Welsh.

The Court: His name appears on the calendar.

The Clerk: I had advance knowledge, your Honor, so I put it on the calendar.

The Court: Is Mr. Welsh a member of the California bar?

Mr. Welsh: Oh, yes, I am a member of this court, your Honor.

The Court: All right. You may proceed, Mr. Mason. [4]

\* \* \* \* \*

The Court: All right. Let us get the testimony.

Mr. Mason: First I would like to offer in evidence the patent in suit, No. 2,475,322.

The Court: All right.

Mr. Mason: And, as I understand it, Mr. Stratton will stipulate the title in the plaintiff.

Mr. Welsh: It is so stipulated.

The Court: All right.

The Clerk: Plaintiff's Exhibit No. 1 in evidence.

(The document referred to, marked Plaintiff's Exhibit No. 1, was received in evidence.)

[See Book of Exhibits.]

Mr. Mason: I will call Mr. Horton. [10]



R. J. HORTON

called as a witness on behalf of the plaintiff, being first duly sworn, was examined and testified as follows:

The Clerk: What is your name, please?

The Witness: R. J. Horton.

The Court: Before you proceed, gentlemen, I think there should be a dismissal as to all the fictitious names, persons or corporations who have not been served.

Mr. Mason: Yes, your Honor. I will move to dismiss as to——

The Court: Doe I, Doe II, and Doe Company.

Mr. Mason: ——all the Doe defendants, your Honor.

The Court: All right, the dismissal will be entered.

Mr. Mason: And I will state at this time, your Honor, that while there is an unfair-competition count in the complaint, we do not intend to present evidence on that as such, except in so far as it may aggravate the infringement.

The Court: All right.

Direct Examination

Q. (By Mr. Mason): Mr. Horton, are you an officer of the plaintiff, D & H Electric Company?

A. Yes, sir.

Q. What office do you hold?

A. I am the sales manager and president of the company. [11]

Q. How long have you held that position?

(Testimony of R. J. Horton.)

A. I have been president of it ever since we incorporated, which was in 1946, I believe.

Q. 1946? A. I believe it was 1946.

Q. Now, does the plaintiff corporation make a coupling device for flexible conduits?

A. Sir?

Q. Does the plaintiff corporation make connectors for flexible conduits? A. Yes.

Mr. Mason: I will ask that this be marked for identification, your Honor, which is the  $\frac{3}{8}$ -inch connector.

The Clerk: Plaintiff's Exhibit No. 2 for identification only.

(The device referred to was marked Plaintiff's Exhibit No. 2 for identification.)

The Clerk: Plaintiff's Exhibit No. 3 is marked for identification only.

(The device referred to was marked Plaintiff's Exhibit No. 3 for identification.)

Mr. Mason: That being the  $\frac{1}{2}$ -inch connector.

The Clerk: Yes.

Mr. Mason: I ask that the  $\frac{3}{4}$ -inch coupling be marked as the next exhibit. [12]

The Clerk: Plaintiff's Exhibit No. 4 marked for identification only.

(The device referred to was marked Plaintiff's Exhibit No. 4 for identification.)

Mr. Mason: The next exhibit for identification is the plaintiff's 1-inch connector.

Mr. Welsh: Will that be Exhibit 5 for identification?

(Testimony of R. J. Horton.)

The Clerk: Plaintiff's Exhibit No. 5 marked for identification only.

(The device referred to was marked Plaintiff's Exhibit No. 5 for identification.)

Mr. Stratton: What size is that?

Mr. Mason: 1-inch.

As the next one, plaintiff's 1/2-inch coupling.

The Clerk: That is Plaintiff's Exhibit 6 marked for identification only.

(The device referred to was marked Plaintiff's Exhibit No. 6 for identification.)

Mr. Mason: As the next exhibit, this 1/2-inch adapter.

The Clerk: Plaintiff's Exhibit No. 7 marked for identification.

(The device referred to was marked Plaintiff's Exhibit No. 7 for identification.)

Q. (By Mr. Mason): I show you, Mr. Horton, Plaintiff's Exhibits 2 to 7, inclusive, for identification, and ask you if you recognize those.

I will start with No. 1.

A. Yes, on No. 1.

Q. Now, what is Exhibit No. 2?

A. Exhibit 2 is a 3/8-inch flexible conduit connector. [13]

Q. All right. No. 3?

A. This is a 1/2-inch flexible conduit connector. This (indicating) is a 3/4-inch flexible conduit connector.

Q. You are referring to Exhibit 4?

A. No. 4.

(Testimony of R. J. Horton.)

This is a 1-inch flexible conduit connector.

The Court: When you say "this," you are naming them.

Mr. Mason: That is Exhibit No. 5.

The Witness: What number is this?

Mr. Mason: No. 6. That should be No. 6. It has not been marked yet.

The Witness: 1/2-inch flexible conduit coupling.

This is known as a flexed EMT adapter (indicating).

Q. (By Mr. Mason): Now, those are all of your manufacture? A. Yes.

Q. And how long have those been on the market? A. Since 1946.

At one time we had a little different collar on it. Then we eliminated that.

The Court: Gentlemen, for the record, let us put something in the record to explain the manner of operation.

Wherein do these couplings differ from ordinary couplings, grooved connecting pipes and things like that, which fit in? [14]

The Witness: Your Honor, this is the type——

The Court: You are talking about exhibit——

Mr. Mason: Let me have it marked, your Honor.

The Clerk: This is Plaintiff's Exhibit No. 8 marked for identification only.

(The device referred to was marked Plaintiff's Exhibit No. 8 for identification.)

Q. (By Mr. Mason): Now, I show you Exhibit No. 8, Mr. Horton, and ask you to explain to the

(Testimony of R. J. Horton.)

court how these connector devices are used and in what manner they differ from the connectors that were on the market prior to your device. And I will ask you to wait for a moment while these are marked.

The Clerk: Plaintiff's Exhibits 9, 10, and 11 marked for identification only.

(The devices referred to were marked Plaintiff's Exhibits Nos. 9, 10, and 11 for identification.)

Q. (By Mr. Mason): I show you Plaintiff's Exhibits 8 to 11 for identification and will ask you to point out to the court how these devices are used and how they differ from the connectors that were in use up to the time you brought yours out.

A. This fitting here——

Q. Referring to Exhibit 8 now?

A. Yes. This fitting here is known as a Thomas-Betts, [15] that has been on the market for many, many years.

Q. While you are on that, will you describe how that is utilized?

A. Well, this acts as a clamp on the flex, and when you pull the wires through, you are supposed to ream the flex. They use this type of flex in most cities.

Q. The clamp fits on the exterior?

A. On the exterior, yes.

My fitting automatically reams the flex and grips it from the inside instead of the outside.

Your Honor, this was the old type flex that they

(Testimony of R. J. Horton.)

have had on the market for many, many years, that is the Thomas & Betts.

This connector works from the outside of the flex to clamp on, using the screws.

The Court: Yes.

The Witness: When using this fitting, they are supposed to ream the inside of the flex. Otherwise they scrape the wires in a lot of cases.

On this type of fitting, when used on motor runs, it will vibrate and work off. It is a very common thing to go to a machine shop or factory and find this fitting has worked out from its fitting.

This fitting here, which is the one I am referring to——

Q. (By Mr. Mason): Now you are referring to the part [16] by which that flexible tubing is connected to the junction box?

A. That is right. This fits into the box the same as it does down at this end.

This is a locknut up here (indicating).

This fitting here screws inside of the flex, which automatically reams the flex and automatically clamps tight so that the vibration does not pull it off.

This one happens to be Stephens', right here.

Q. That is the defendant's device?

A. The defendant's.

This one is mine (indicating).

Q. Now, you have been describing this shorter one of those conduits, is that right?

A. That is right.

(Testimony of R. J. Horton.)

The Court: The point I am trying to get at is, wherein does that differ from an ordinary coupling where you thread in opposite directions two pieces of pipe and screw them together? Wherein does this differ from that?

Mr. Mason: I was going into that with Mr. Berry, your Honor, with drawings. It is difficult to explain it.

The Court: Well, I want to get an idea, I want to get a main idea so I will see what you are talking about.

The Witness: I think this one here will give him a better example of it. [17]

The Court: Yes.

The Witness: In here, this is known as a coupling, a flexible conduit coupling.

Q. (By Mr. Mason): You are referring to Exhibit 9?

A. You loosen those four screws and take that out in order to use it.

The Court: Yes.

The Witness: This here (indicating) fits inside.

May I use those tools, please, so I can take this apart?

The Court: Yes.

Q. (By Mr. Mason): You are now referring to the plaintiff's device, a coupling device?

A. Yes.

Can you hold that, Mr. Mason?

Mr. Mason: Yes.



(Testimony of R. J. Horton.)

The Witness: You better hold on to the pliers. You can't hold it there.

The Court: I didn't mean to give you all that work.

The Witness: Well, I can show you on the smaller size here. This is the smaller size of coupling.

The Court: All right, go ahead.

The Witness: This screws inside of the flex, which automatically reams it and automatically makes a perfect ground all the way through it. This type of fitting——

Q. (By Mr. Mason): Referring now to Exhibit No. 6, [18] which you just referred to, can you unscrew this without the use of tools after inserting it into the pipe?

A. Not if it is flexed to Underwriters' specifications, measurements.

Now, this type here——

Q. Referring to Exhibit——

A. No. 8, I believe it is, isn't it?

Q. ——No. 9.

A. No. 9, this fitting here is limited to so many places because of its screws and the fact that it works its way out.

The Court: Yes.

The Witness: You cannot use it in a concealed wall or motor runs or any place like that. If you have a wide-open space, say a two-foot working clearance, you can use this type of fitting provided it is not on a motor works.



(Testimony of R. J. Horton.)

This fitting (indicating) you can use on all motor works or in the walls or any place, extending around, or use it to put short pieces of flexible conduit in.

The Court: All right.

Q. (By Mr. Mason): Now, you have been referring here to Exhibit No. 9. In the earlier part of that discussion you were referring to this sleeve-like clamp on one end of this tubing, and in the latter part of your answer you were referring to the coupling marked "DH" here as part of [19] Exhibit No. 9? A. That is right, yes.

Q. Now, this coupling exhibit marked "DH", is that one of the defendant's or one of yours?

A. That is mine.

The Court: I see.

Q. (By Mr. Mason): Now you are referring to Exhibit 11. Will you explain that?

A. This is the way we used to have to do when we used it for stubouts for garage runs, or for little concrete block houses, or for motor runs, where we were coming down a wall with steel tubing leading to a motor run, we would have to put on a steel tube connector and clamp it with a pipe coupling and a flex connector to extend it over for a motor run. I eliminated those by using this type DH 1050T here.

Now, tightening up here——

Q. You are referring now to Exhibit 10.

A. There is a little expansion ring inside of that, that makes that draw tight.

(Testimony of R. J. Horton.)

The Court: Yes.

Mr. Mason: I don't know whether you have explained to the court the manner in which your connector differs——

The Court: Gentlemen, have you a paper copy of the patent?

Mr. Mason: Yes, your Honor.

The Court: I would like to have an extra copy. I just [20] want to have it in front of me.

All right. Go ahead.

Mr. Welsh: We have a prior-art book also, your Honor.

The Court: All right. Go ahead.

Mr. Mason: Will you read the question as far as I went, please?

(The record was read by the reporter as follows:

“Mr. Mason: I don't know whether you have explained to the court the manner in which your connector differs——”

Q. (By Mr. Mason—continuing): ——from conventionally threaded connector.

A. Well, my fitting screws inside, automatically reams the flexible conduit. It automatically makes a perfect ground for the flex, which is a big item in the wiring. It will not vibrate off. You can vibrate it all day long and it will not shake off, where other types of fittings do.

Q. Do you know why that is?

A. It cross-threads.

Mr. Welsh: I would like to move to strike what-

(Testimony of R. J. Horton.)

ever part of the answer has been given, for the purpose of an objection, your Honor. I would like to object to the question on the ground that it is too all-inclusive. The question was regarding other types. I think we should limit ourselves to the type he is speaking of. [21]

The Court: No, no. He was asked to show the difference between this and the ordinary threaded coupling, which is what I wanted to find out. The motion will be denied.

Go ahead.

The Witness: This fitting acts as a cross-thread when it goes in——

The Court: Yes.

The Witness: ——which pulls this down (indicating), as you can see, and makes it grip tight.

The Court: In other words, as I get it, if you use this, then you don't need to worry about threading or anything like that, it just goes in and stays in, is that it?

The Witness: You have to screw it in. Yes.

The Court: You screw it in?

The Witness: Yes.

The Court: And it stays in?

The Witness: That is right, and it makes a connector.

The Court: And are these conduits now made in standard sizes, all of them, or are they of different sizes, I mean for ordinary wiring like in the Los Angeles area where everything has to be in conduits?

(Testimony of R. J. Horton.)

The Witness: Every city has its code, and then we have what we call the National Code, and it varies. Now, in five districts, they can use conduit or flexible conduit.

The Court: I mean, do conduits come in standard sizes? [22] Is that a standard size?

The Witness: Yes.

The Court: Or do they come in different sizes?

The Witness: We have what we call the Fire Underwriters' specifications, that they have to live up to.

The Court: I see.

The Witness: Now, once in a while there will be a piece of flex get on the market that is over-size. Now, we have a book of standards to go by.

The Court: All right. That is all I want to know. Go ahead.

(Coupling and conduit were marked Plaintiff's Exhibit No. 12 for identification.)

Q. (By Mr. Mason): I show you plaintiff's exhibit marked for identification as Plaintiff's Exhibit 12 and ask you if you know what that is?

A. This is known as a Jake connector. This has spiral for screwing inside. You see, this screws right inside, it follows the conduit right around; by running up, jamming on this——

The Court: And will that work on any standard conduit?

The Witness: Yes.

Q. (By Mr. Mason): Now, in the connector that you have just referred to, Exhibit No. 12——

(Testimony of R. J. Horton.)

A. My hands were too slippery. Take it out. Let me [23] take it out.

The Court: Yes.

The Witness: I rolled it up over this (indicating).

The Court: Speak up so the reporter can hear you.

The Witness: I had run it over, over this little shoulder here, so as to make it bind when I screwed it in there, see.

Now, I just run it down and then just butt it (illustrating).

But if you put this collar on, then it holds. But without the collar, it doesn't hold.

The Court: Then it doesn't hold.

(Lengths of conduit were marked Plaintiff's Exhibits Nos. 13, 14, 15, and 16, respectively, for identification.)

The Clerk: Plaintiff's Exhibits 13, 14, 15, and 16 marked for identification only.

Q. (By Mr. Mason): I show you Plaintiff's Exhibits 13 to 16, inclusive, for identification, and ask you to explain what those are.

A. This is known as  $\frac{3}{8}$ -inch flexible conduit or what is called Greenfield in the East, but in the West it is called flexible conduit.

Q. You are referring to Exhibit 13?

A. This is  $\frac{1}{2}$ -inch flexible conduit or Greenfield [24] (indicating).

This (indicating) is  $\frac{3}{4}$ -inch flex conduit.

This (indicating) is 1-inch flexible conduit.

(Testimony of R. J. Horton.)

Q. Now, would you say that those are typical lengths of flexible conduit such as are sold for use in connection with junction boxes?

A. Typical in sizes.

Q. Have you marked the devices marketed and sold by the plaintiff with the number of the patent in suit?      A. Yes, I have.

Q. Can you tell the court in round figures approximately how many of these coupling devices which you have described you have sold since you started in 1946?

A. Not exactly. I can give it approximately.

Q. Just approximately, in round figures?

A. Four million, or better.

Q. Could you give the dollar value of those?

A. Approximately, or just a rough guess, \$200,000.

Q. What?      A. \$200,000 worth.

Q. When did it first come to your attention that the defendants were manufacturing a coupling device such as you are complaining about in this action?

A. We got a letter from our agent in St. Paul, I believe it was in '50, '51, 1950 or '51, I am not positive [25] on that. I would have to check the records to see.

Q. Is that the first information you had that the defendants were infringing?

A. Yes, it was.

Mr. Welsh: Your Honor, I move that the answer be stricken on the ground that the testimony is

(Testimony of R. J. Horton.)

hearsay and not the best evidence, and incompetent, irrelevant, and immaterial.

The Court: Will you read the question and answer?

(Record read as follows:

("Q. When did it first come to your attention that the defendants were manufacturing a coupling device such as you are complaining about in this action?

("A. We got a letter from our agent in St. Paul, I believe it was in '50, '51, 1950 or '51, I am not positive on that. I would have to check the records to see.'")

The Court: I will strike the answer. You can give the date and the time, and the manner can be determined later on.

Q. (By Mr. Mason): I will ask you to state when you first saw the device of the defendant.

A. When I first saw it was in San Francisco, in 1951. I believe it was in October. Very possibly it was in November. Approximately that date.

Mr. Mason: Will you mark these, please?

(Devices were marked Plaintiff's Exhibits Nos. 17, 18, 19, 20, 21, and 22, respectively, for identification.) [26]

The Clerk: Plaintiff's Exhibits 17, 18, 19, 20, 21, and 22 marked for identification only.

The Court: While you are having those marked, let us have a brief recess.

(Recess.)

The Court: You may proceed.



(Testimony of R. J. Horton.)

Q. (By Mr. Mason): I show you Plaintiff's Exhibits 17 to 22, inclusive, and ask you if those are the defendants' devices which you charge to infringe?

A. Yes. This is one (indicating); yes, yes.

The Court: Now, are we keeping track of all of these, Mr. Childress?

The Clerk: As long as the tags stay on them, yes, sir.

The Witness: I have one here without a tag on it. This one right here.

The Court: Take it away, then, until you start using it.

The Witness: This is the tag, I believe, right here.

Mr. Welsh: Maybe we better find out. What is the description of Plaintiff's Exhibit No. 12, Mr. Childress?

The Witness: That is a 1/2-inch Jake coupling.

Mr. Welsh: Yes, that is it.

Q. (By Mr. Mason): Does your company put out any advertising literature? A. Yes.

Mr. Mason: May I have these marked? [27]

(Documents were marked Plaintiff's Exhibits

Nos. 23 and 24, respectively, for identification.)

The Clerk: Plaintiff's Exhibits 23 and 24 marked for identification.

Q. (By Mr. Mason): I show you Plaintiff's Exhibits 23 and 24 for identification and ask you if those are items of your advertising?



(Testimony of R. J. Horton.)

A. Yes. We have a later sheet that shows the 90-degree connector in it. That is the older.

Q. And on Exhibit 24, does that show your prices?

A. Yes, but this is an earlier price list. Since we have had to drop our prices, these are changed now.

Q. How does the price at which the D & H Electric Company sells its connectors compare with the price at which the defendants sell their connectors?

Mr. Welsh: I object to the question as being incompetent, irrelevant, and immaterial. The prices at which the two parties sell their connectors do not bear upon the issues before this court. The unfair-competition count was dismissed, as your Honor will recall.

Mr. Mason: I think it goes to show the aggravation of the infringement, your Honor.

The Court: I think, if there is infringement, there is no question of aggravation.

Mr. Mason: Well, I will withdraw the question then. [28]

The Court: We do not allow punitive damages in patent infringement. I will sustain the objection. It doesn't bear on anything.

He might tell us the success of it by telling us what sales he made, either in money terms or in identical terms, and all that. That is permissible as preliminary.

Mr. Mason: He has testified to that, your Honor.

The Court: I thought he did.

(Testimony of R. J. Horton.)

Mr. Mason: Yes.

The Court: And the fact that he was undersold, I don't think is material. I will tell you the only case in which I allowed it. I don't know whether it was your case. You gentlemen are before me in so many different capacities, on one side or another, I can't tell which—the only case in which I allowed it was in a case where a person had had a contract with the inventor and then he decided that by making them he could save money. In that case, I allowed it, allowed it to go in, because of the relationship that existed, to explain why he may have indulged in this infringement. I forget which case it was. I wrote an opinion on it, I remember. I remember the case but, except in a case like that, to show that it was not fortuitous, that is the point I am making, to show that the infringement was not fortuitous, but, even if it was fortuitous, it doesn't make any difference, intent is not material. If it infringes, it infringes, whether [29] you have intended to or not. But, of course, where you set out deliberately to do a certain thing, to imitate a thing which you had used under a license before, then it has a bearing on the suit, but, except in a case like that, the price at which it was sold would not bear on the matter.

I will sustain the objection.

Q. (By Mr. Mason): Now, where is the office and place of business of the plaintiff corporation?

A. What?

(Question read.)

(Testimony of R. J. Horton.)

A. It is in Los Angeles.

Mr. Mason: You may cross examine.

The Court: Now, before you go on, have all these been offered?

Mr. Mason: No, your Honor. I will. Thank you for calling it to my attention.

The Court: Well, unless you have to tie them up, I think they ought to go in before cross examination begins.

Mr. Mason: I think the patent was received.

The Court: Yes, the patent is already in.

Mr. Mason: I would like to offer Exhibits 2 to 24, inclusive.

The Court: Yes, they may all go in.

Mr. Welsh: There is no objection. Only the exhibits that have been marked were offered, your Honor. [30]

The Court: All right.

Then the clerk has to change the stamp on the markings. Then all of these are in now.

(The devices, objects, and documents referred to, marked Plaintiff's Exhibits Nos. 2 to 24, inclusive, were received in evidence.)

The Court: All right, go ahead.

### Cross Examination

Q. (By Mr. Welsh): Mr. Horton, when exactly did you start to produce your connector?

A. We started, I believe it was, in March or in April of 1946.

Q. In March or April of 1946, but do you have

(Testimony of R. J. Horton.)

any records to show when you started production of your connectors?       A. Yes.

Q. Do you have those with you?

A. I am not sure that I have; no, we don't have them with us.

Mr. Welsh: Will you have them here this afternoon, sir? Can you have them here this afternoon?

Mr. Mason: Well, their office is quite a way from here. I don't know what the materiality is.

Mr. Welsh: Well, I am determining how soon prior to the [31] application for the patent production was started.

The Court: Well, I gather your only defense is non-infringement. You are not attacking the validity of the patent?

Mr. Welsh: Yes, sir, we have a count in there, a defense on the validity of the patent.

The Court: How is that? Well, the general one that it wasn't within the two-year period, or what?

Mr. Welsh: Well, we have alleged, your Honor, all of the classic defenses.

The Court: Yes, I know it is very difficult to get you patent lawyers away from those classic answers.

Mr. Welsh: Frankly, we do not have any evidence to show that the patented product was produced more than a year before the application, and we don't know, and I think we are entitled to ask that question. The only way we can know is from the witness.

The Court: Well, if he doesn't have it available, you will have to take his word for it, and the fact

(Testimony of R. J. Horton.)

that we don't have better evidence, and I don't want to continue the case. It looks to me like a rather simple case involving rather simple issues.

Mr. Welsh: It won't take longer.

The Court: All right. If you can bring it here this afternoon, bring it back at 2:00 o'clock. [32]

The Witness: What time will we close?

The Court: At 12:00 o'clock. Can you be back at 2:00 o'clock?

The Witness: I will be able to go there and back, I think.

The Court: If you are delayed a little, it won't matter. They can put on another witness then, but be back as near to 2:00 o'clock as you can.

The Witness: Yes.

The Court: All right. He will get it for you.

Mr. Welsh: Thank you, sir.

Q. Now, what part, if any, did Mr. O. K. Jones have to do in the invention of yours, Mr. Horton?

A. Nothing. He was chief electrical inspector of the City when we patented this.

Q. Were any of the ideas of the invention given to you by O. K. Jones?

A. No, sir.

Q. Are you the sole inventor?

A. Mrs. Horton and myself.

The Court: Was she the Bryane in the patent?

The Witness: Yes, she was the Bryane at the time.

Q. (By Mr. Welsh): Did Mrs. Horton, or the

(Testimony of R. J. Horton.)

former Miss Bryane, contribute anything to the conception or development of the invention? [33]

A. We both worked together on it all the way through.

Q. When you first put out your product, your connector, did you at that time mark it with anything from the Patent Office, with any patent number?

A. Not a patent number. At first I believe we had "Patent pending." I am not positive of that. It has been so long ago since I have seen one.

"Patent applied for," I believe it was.

Mr. Welsh: May I have this marked as defendants' exhibit first in order?

The Clerk: Defendants' Exhibit A marked for identification only.

(The device referred to was marked Defendants' Exhibit A for identification.)

Q. (By Mr. Welsh): I show you Defendants' Exhibit A for identification and ask you if you will please tell me what that is, sir?

A. I can't read the numbers on it, but the "D & H" I can see.

Q. Well, describe the item that I hand to you.

A. It is a D & H  $\frac{3}{4}$ -inch connector.

Q. I will read this number here, "668,790," and your counsel can check me on it. Does that number mean anything to you?

A. I don't know the numbers. [34]

Q. Well, is that the patent number?

A. I don't know.

(Testimony of R. J. Horton.)

Q. Well, did you ever mark your device with any number other than the patent number?

A. At first we had the wrong number on, through an error of the office that had given us the number.

Q. And the patent number actually is over a million, isn't it?      A. I really don't know.

Mr. Welsh: Well, counsel, will you stipulate that this number is the number of the application?

Mr. Mason: What is the number?

Mr. Welsh: The number is 668,790.

Mr. Mason: Yes.

Q. (By Mr. Welsh): When did you first put that number on this Defendants' Exhibit A for identification, the number 668,790?

A. I don't know the exact dates.

Q. Well, can you tell me in relationship to the time the patent was issued, when you put it on?

A. I would say within a month or two, approximately.

Q. One or two? A month or two, or what?

A. After we had gotten the number.

Q. Now, the serial number that I have just read, 668,790, was first given to you by the Patent Office on May [35] 10, 1946. Is that when you put the number on your device?

A. I would say not.

Q. Do you know how many connectors you made with this number, or for how long a period of time you had this number on it?      A. No, I don't.

Mr. Mason: I will state, counsel, that Mrs.



(Testimony of R. J. Horton.)

Horton has more detailed information as to that, and I will make her available for questioning regarding it.

The Court: What is the answer to this inquiry? Certainly they didn't have any. I presume the numbering is not given until the patent is issued, although I assume the number of the application is given out. I don't see the object of the inquiry.

Mr. Welsh: Well, your Honor, it goes to the question of notice, of how long notice was given to other persons that he had a patent, because this is not a patent number, and it also would go to the question of coming in with unclean hands if it were marked prior to the time that any patent whatsoever was given.

The Court: What number has it there?

Mr. Welsh: It has the application number 668,790.

The Court: That would be legitimate.

Mr. Welsh: No, sir. The application number has nothing to do with the patent number. [36]

The Court: But a layman might think that that is the number which he is going to get ultimately.

Mr. Welsh: I realize that it can be made by pure error, there is no question about that, but if it is put on here, the application number can be put on as soon as the application is made, and if it is put on as soon as the application is made but before the patent was issued, it would then be misrepresentation.

The Court: Oh, well——



(Testimony of R. J. Horton.)

Mr. Welsh: I would like to offer this.

The Court: All right. It may be received.

The Clerk: Defendants' Exhibit A in evidence.

(The device referred to, marked Defendants' Exhibit A, was received in evidence.)

Q. (By Mr. Welsh): Now, your counsel has introduced several of these various devices and you have all of them in front of you, I think, here, Mr. Horton, and you were explaining to the court how yours differ from these various devices. Now, with the exception of the Jake device, Plaintiff's Exhibit No. 12, none of the other devices were cited by the Patent Office when you made your application, were they?

A. I wasn't asked that question.

Q. I am asking it now.

The Court: That is a question of fact, but I don't think he should be asked that question. He is not a patent [37] counsel. It is quite evident, unless the file wrapper contains others. The patent on its face shows that the only prior art mentioned was that given in the patent file, from Adamson to Jacobi, and a foreign patent—six patents.

Mr. Welsh: Let me amend the question.

Q. The connector for conduits to junction boxes, such as mentioned, similar to yours and prior to yours, was this Jake connector, Exhibit No. 12, is that right?

The Court: If he knew that. Ask him if he knew that at the time.

Q. (By Mr. Welsh): Did you know of the

(Testimony of R. J. Horton.)

Jake connector at the time you made your invention?

A. Well, I got to checking over here a few days ago the first time that I had seen a Jake connector, and it definitely was after, and I had stated at another time that I had seen it before, but I hadn't.

Q. Do you remember when your deposition was taken you stated that you had seen the connector?

A. Yes, I did, but in checking it back over I feel sure that I hadn't seen it before, because I know at the time when this came up, then is when I went out and found them.

Q. How was it that at the time your deposition was taken you testified under oath, as you just said, that you knew of the Jake connector before your invention? Now you say you made a check. What kind of a check did you make to [38] determine that?

A. Well, I had never bought from General Electric, and General Electric was the company that had carried those types of fittings.

Q. And you never had seen it before you bought it from General Electric?      A. No, sir.

Q. Do you have records that show when you first bought from General Electric?

A. I do not, but I know that I went there and bought them afterwards, after I had heard about the Jake, to check it, to see what it was.

Q. It is your belief now that you didn't know of the Jake before you made your invention?

A. It is my belief that I didn't, yes.

(Testimony of R. J. Horton.)

Q. And it was your belief that you did, several months ago when your deposition was taken, is that right?

A. At that time I was confused on it.

Q. And now you are perfectly clear?

A. Yes, I have checked into it.

Q. Has there been any change in the manner in which you have manufactured your connector since 1946?

A. In the principle of it, no.

Q. Well, have there been any changes?

A. When I first started, I had a collar on it. When [39] I first made my first connector, I didn't have a collar on it, but they asked me to have a collar put on it, which I fought and tried to get away with and I didn't succeed. Later we eliminated the collar, but the principle of it has been the same all the way through.

Q. Other than that, have there been any changes since 1946?

A. Not in the principle of it, no.

The Court: Aside from the principle, has there been any change in the structure?

The Witness: Eliminated the collar, sir, your Honor.

The Court: You eliminated the collar?

The Witness: Yes.

Q. (By Mr. Welsh): Is that all?

A. It had more fittings, different types for fittings.

(Testimony of R. J. Horton.)

Q. By "different types," you mean difference in the angles? A. One-half——

Q. Different sizes? A. Different sizes.

Q. But, other than that, no changes, is that right? A. Nothing that I know of.

Q. Did you change the size of the ribs, either by making them longer or higher?

A. Not since we went through Underwriters.

Q. When was that?

A. We experimented, trying the different sizes of lugs to see what difference it would make when we went through Underwriters, and I believe that was in 1948.

Q. You believe it was when?

A. I believe it was 1948.

Q. What change did you make then, when you went through Underwriters?

A. They were the same as before, with the exception of one connector that has a larger lug, a little bit larger lug.

Q. By "lugs," you mean these things I have drawn on here (indicating sketch)? A. Yes.

Q. These things. When you say it is larger, do you mean it is longer or higher?

A. It is higher.

Q. It is higher. When did you first put that change into manufacturing operations? In other words, when did you first put out on the market a connector with a lug that was higher?

A. As soon as the second time we went to Un-

(Testimony of R. J. Horton.)

derwriters, we came back and experimented with it to see if it would make any difference.

Q. You see, I don't know when you went to Underwriters, so if you can tell me the dates or the year? [41]

A. I can't tell you the date.

Q. In what year?

A. I believe it was in 1948.

Q. Pardon me?

A. I believe it was in 1948.

Q. It could have been later?

A. Not on the half-inch. We have had other fittings that went into the Underwriters later than that.

Q. Well, my original question was, were any changes made? In other words, you have made changes on other than the 1/2-inch ones later than 1948, is that right?

A. I don't know of any.

Q. Pardon me?

A. I do not know of any.

Q. Would Mrs. Horton know that?

A. I doubt it.

Q. As far as you know, if Mrs. Horton knows that, of course, if you know whether she knows it or not?

A. I doubt it.

Q. I beg your pardon?

A. I doubt it.

Q. But you did increase the height of this lug, as you refer to it?

A. One of the connectors.

Q. What material is this made of? [42]

A. Zamak No. 5.

Q. Is that a type of zinc?

A. Yes.

(Testimony of R. J. Horton.)

Q. And of what material is the flex made?

A. Steel, aluminum-steel.

Q. The steel is harder than the zinc, I assume, is that right?      A. It should be.

Q. Then your coupling doesn't actually abrade the flex?

A. It cuts the thin edge of a burr that is left on the flex. Regardless of the angle you cut your flex on, you have a burr on a setscrew in there that it actually leaves.

Q. It shaves off a part of the device? In other words, your device has softer metal so that it would compress your device, isn't that correct?

A. Not necessarily.

Q. Well, do you know whether it does or it doesn't?      A. I don't think so.

Q. You don't know, do you?

A. I am not positive.

Q. Reading from your patent, your claim provides for "a coupling for spirally wound, flexible conduits, a tubular member having means at one end adapted to be affixed to the wall of a junction box or the like," and so forth. Now, does this connector that you have in evidence here, which is [43] designated as Plaintiff's Exhibit No. 6, have the means at one end to adapt itself to a junction box or the like?      A. It does not.

Q. It does not?      A. It does not.

This is the coupling.

The Court: What is the number?

Mr. Welsh: No 6.

(Testimony of R. J. Horton.)

The Court: You were going to say something?

The Witness: This is the coupling.

The Court: Yes.

The Witness: This is the connector that goes to a box.

The Court: Yes.

The Witness: One with threads at the end.

The Court: All right.

Q. (By Mr. Welsh): Now, even the standard flex which the Underwriters Laboratories authorize is subject to some variation in size, is it not, small variations in size?

A. Small variations, yes.

Q. Is it true that your connector will stick very tightly if the variation is on the minimum side, but that it might be easy to take your connector out if the flex is on the large side, if I make myself clear?

A. Not if it is Underwriters' specifications.

Q. In other words, your connector, even on what we might [44] call the largest size, the largest perimeter variation——

A. Yes.

Q. ——even on that you cannot unscrew it without using pliers or something of that sort, is that right?

A. Sometimes you can; but the majority, no.

Q. Now, your connector is marked with the letters "MS"? A. Definitely not.

Q. Excuse me. "DH", that is correct?

A. Yes.



(Testimony of R. J. Horton.)

Q. And the accused connector is marked with the letters "MS", is it not?      A. Right.

Q. And to cause the junction of your device, you stretch the conduit into which it is inserted, is that correct?      A. That is right.

Q. Now, looking at my diagram here, is it not true, sir, that when your connector is inserted into the flex, the pressure of the flex is applied at either end of the lugs as you have described them? If you know.

A. I think my witness who will follow me will be able to give you a better description than I can.

Q. You don't know the answer to that?

A. No. [45]

Q. Well, generally, though, you can answer this, can't you: The principle of your patent is a cross-threading one, is that right?

A. A jammed thread.

Q. A jammed thread or cross-thread. In other words, it doesn't mate with the convolutions of the conduit?      A. That is right.

Q. Is that correct?      A. It does not.

Q. And consequently has a jamming or a cross-threading action?      A. Yes.

Q. And in that way does it differ from the Jake patent?      A. Yes.

Q. The Jake patent is meant to mate, is that right?

A. It is meant to follow the spiral of the flex.

Q. That is what I meant by mating.

A. Yes.



(Testimony of R. J. Horton.)

Q. Yes. Thank you. Can you tell me why you decided to raise the lugs on your device?

A. In experimenting with it——

Q. Well, I assume that, but I mean, what was the result of the experiments that led you to that conclusion?

A. Running into flex that was not of Underwriters' specifications, in trying to overcome that. Instead of that, [46] we went to the Underwriters and had them go to the flex people and bring it up to their specifications.

Q. Well, it actually worked better on the Underwriters' specified flex, didn't it, when you raised the bumps?

A. Not necessarily.

Q. Then you are not allowed, are you, to use flex that doesn't meet Underwriters' specifications?

A. Can you stop them? The electrical people can't.

Q. You don't sell yours for that purpose though, do you? You do not advertise it to meet——

A. Definitely not.

Q. No. And you do not advertise it to meet unauthorized flex, do you?

A. No, sir.

The Court: Well, you aim to conform. Of course, leaving aside the standard of the Building Code, there are places where the minute details as to conduits, and so forth, that we have in the Los Angeles ordinances, do not apply, isn't that true?

The Witness: We have a National Code and the Fire Underwriters, which try to make them live up to specifications, but in a lot of places there will

(Testimony of R. J. Horton.)

be machines that will bet out of adjustment, or there will be oversized flex that will get on the market. If they catch it and determine it, they will make them pick them up. [47]

The Court: That is right, but you do not particularly cater to that type of patronage?

The Witness: Definitely not.

The Court: You try to deal with those who are standard?

The Witness: Legitimate places.

The Court: Standard.

The Witness: That is right.

Q. (By Mr. Welsh): Do you know what angle your lug or rib makes with the longitudinal axis of your device? A. No, sir.

Q. Do you know approximately what it is?

A. No, sir.

Q. You have no idea?

The Court: He says he doesn't.

The Witness: I have a man that has the instruments there that can show that.

Q. (By Mr. Welsh): Do you know what angle the lugs or the ribs on the accused device make?

A. No.

Q. You testified to the amount of volume and the amount of money,—

A. Approximately.

Q. —in selling your devices since 1946. Has it increased each year, or what has been the history of the company in sales? [48]

(Testimony of R. J. Horton.)

A. That I would have to leave up to Mrs. Horton.

Q. Well, you know in a general way?

The Court: Well, in a general way? We are not holding an accounting now.

Q. (By Mr. Welsh): Just in general?

A. It has increased.

The Court: It has increased?

The Witness: Yes.

Q. (By Mr. Welsh): It has increased after 1950, 1951 was a little better than 1950, and 1952 better than 1951?

A. I would say after I started traveling, it increased.

Q. When did you go on the road?

A. In 1951.

Q. In 1951. It was better in 1952 than it was in 1951, was it, your business was of a larger volume, a larger gross?

A. I can't say.

Q. Was it better in 1953 than in 1952?

A. I wouldn't be able to give you the exact figures on that.

Q. No, I don't want the exact figures. Just generally, have you done better?

A. It is about the same.

Q. What connection do you have with the plaintiff company, D & H Electric Company, what is your position?

A. I am the president of it and the sales manager. [49]

Q. Well, you have a general idea of the financial

(Testimony of R. J. Horton.)

condition and whether you are doing better or not, as president?

The Court: He has given you his best recollection. I do not think you should take the time trying to pin him down to details. He may be wrong.

Mr. Welsh: I just want a fair answer as to whether it was better or whether it wasn't better.

The Court: Well, he said it was better.

Mr. Welsh: Very well, sir.

The Court: The reason we allow that is to show the patent is reduced to practice and it is not a mere paper patent. That is the only object of showing it has had success. As to the details of it, that is a question of accounting when you get to that.

Q. (By Mr. Welsh): Mr. Horton, you know of no instance where there has been any confusion in the minds of the public as between your device and the accused device?      A. Yes, I have.

The Court: Well, I am going to sustain the objection that should have been made. Confusion of source is not an element in a patent-infringement case. Confusion of source is a matter in an unfair-competition cause.

Mr. Welsh: That is true, your Honor.

The Court: It is also a matter in trade-mark causes. [50]

Mr. Welsh: I withdraw it. It was in my notes before the dismissal of the other cause of action.

The Witness: It shows right here, your Honor.

The Court: Just a moment. When we start talking, you quit talking.

(Testimony of R. J. Horton.)

The Witness: I am sorry.

The Court: We are not interested in that. Confusion of source is not material in this case.

Mr. Welsh: That is all we have for now.

The Court: All right. You will examine him as to the other when he brings that in.

Is there any redirect at the present time?

Mr. Mason: No redirect.

The Court: Step down and you can go ahead and try to get that information. You better get together with Mr. Welsh.

Leave those there. You are through with them.

The Witness: I want my tools.

The Court: Yes, you can take your tools.

You get together with counsel and see what information he wants, so that you won't make a trip for one thing and then they might want something else.

All right, gentlemen, 2:00 o'clock.

(Whereupon a recess was taken until 2:00 o'clock p.m. of the same day, Tuesday, January 5, 1954.) [51]

Los Angeles, Tuesday, Jan. 5, 1954, 2:00 p.m.

The Court: You may proceed.

Mr. Mason: If your Honor please, I would like permission to recall Mr. Horton for two or three questions. I would like to have him make a demonstration.

The Court: All right.

R. J. HORTON

recalled as a witness on behalf of the plaintiff, having been previously duly sworn, testified further as follows:

Direct Examination

Q. (By Mr. Mason): Mr. Horton, I show you Plaintiff's Exhibits 2, 3, 4 and 5, as well as Plaintiff's Exhibits 13, 14, 15 and 16, and I will ask you first if you will take Exhibit No. 2 and insert it in the end of Exhibit No. 13, which is the conduit, and state whether or not you find that it enters freely when you rotate it relative to the conduit and whether it becomes locked after the insertion.

A. This should have the string off so as to keep it from binding on it.

The Court: Well, put it back when you are through, and that is all right.

The Witness: My hands are sweaty.

Q. (By Mr. Mason): Do you need to tighten it any more? [52]

Q. Well, it should go up a little tighter.

Q. Well take your pliers, if you will.

(The witness uses pliers on device.)

Q. Do you find that that has become locked?

A. Yes.

Q. Will you demonstrate?

A. (Witness demonstrates.) If you put enough pressure on it, you can take it off.

Q. But you did find that it had become locked relative to the tubing after you had inserted it?

(Testimony of R. J. Horton.)

A. Yes.

The Court: Let me see it.

Q. (By Mr. Mason): Now, I will ask you to take the device, which is one of the plaintiff's connectors, and insert it in the conduit, Exhibit 14, in like manner.

A. My hands are too sweaty to draw it up.

(Witness does as requested.)

Q. Now, will you see if you can remove that with your hands?

A. (Witness demonstrates.) No.

Q. Now, will you remove it with your pliers?

A. (Witness does as requested.)

The Court: Is that the accused device?

Mr. Mason: No, your Honor. These are the plaintiff's.

The Court: Number two is his, too? [53]

Mr. Mason: No. That is just a different size, your Honor.

Mr. Welsh: They are both plaintiff's devices, your Honor.

The Court: They are both plaintiff's devices.

Mr. Mason: All these four are plaintiff's devices.

The Court: I see.

Q. (By Mr. Mason): Now, is it a correct statement, Mr. Horton, that it did rotate into the conduit freely but became locked and you had to take a pliers to remove it? A. Yes.

Mr. Welsh: I object to that as a leading question, your Honor.



(Testimony of R. J. Horton.)

The Court: Well, I know we saw that happen. Now, what is the object of the demonstration?

Mr. Mason: I just want to show how they operate and show that the plaintiff's and the defendants' operate in the same manner, but we had four different sizes and I had to take four different ones.

The Court: All right.

Q. (By Mr. Mason): Now, I will ask you to take Exhibit No. 4 and insert it in Exhibit 15 in like manner.

A. (Witness complies with counsel's request.)

Q. Now, is that locked, in that position?

A. Yes. [54]

Q. Now, will you determine whether you can remove it freely with your hands?

A. (Witness demonstrates.) No.

Q. Remove it with the pliers then.

A. (Witness complies with counsel's request.)

The Court: All right.

Q. (By Mr. Mason): Now, will you take Exhibit No. 5 and insert it in Exhibit 16 in like manner?

A. (Witness complies with counsel's request.)

Q. Now, can you state whether or not that has become locked?      A. Yes, that is locked.

Q. Can you remove that with your hands?

A. I can. I did not have it locked. I am sorry.

Q. Well, lock it, then.

A. My hands are too slippery to do it by hand.

Mr. Welsh: Are you still using plaintiff's devices?



(Testimony of R. J. Horton.)

Mr. Mason: Yes, plaintiff's devices.

(Witness demonstrates.)

The Witness: I can't take it out. I can't take it out.

(Witness uses pliers in separating devices, being assisted by Mr. Welsh.)

Q. (By Mr. Mason): Did you find that that became locked in the tubing?

A. Yes, sir. [55]

Q. Now, I will ask you to take the defendants' devices; first Exhibit 17, and insert it in Exhibit 13, and state whether or not you get the same results.

A. (Witness complies with counsel's request.) I could not remove it by hand.

Q. Now, do you find that that has become locked? A. Yes, it has.

Q. Now, can you remove it without the use of pliers? A. I cannot.

Q. Well, remove it, please, with the pliers.

A. (Witness complies with counsel's request.)

Q. I will ask you to take Exhibit 18, which is defendants' device, and insert it in Exhibit 14, and state the result.

A. It is in his.

Q. Now will you determine whether or not you can remove it with your hands without the use of pliers?

Mr. Welsh: I am sure I can't, if you can't.

A. I cannot.

(Testimony of R. J. Horton.)

Q. (By Mr. Mason): And you found that it had become locked, did you?      A. Yes.

Q. Will you remove it, then, with the pliers?

A. (Witness complies with counsel's request.)

Q. Now I will ask you to take Exhibit 19, which is one [56] of defendants' devices, and insert it in Exhibit 15.

A. (Witness complies with counsel's request.)

Q. Now will you test it to see whether or not it is locked?

A. (Witness demonstrates.) I can't.

Q. Is it locked so that you cannot remove it with your hands without the aid of pliers?

A. That is right.

Q. Now will you remove it with the pliers, then?

A. (Witness complies with counsel's request.)

Q. Now I will ask you to take Plaintiff's Exhibit 20, which is the defendants' 1-inch coupling or connector, and insert it in Exhibit 16.

A. (Witness complies with counsel's request.)

Q. Now will you test to see whether or not it is locked?

A. (Witness demonstrates.)

Q. What did you find?      A. It is locked.

Q. Now will you take the pliers and remove that, please?

A. (Witness complies with counsel's request.)

Mr. Mason: You may cross-examine. [57]

#### Cross Examination

Q. (By Mr. Welsh): Mr. Horton, I will ask you

(Testimony of R. J. Horton.)

to examine Plaintiff's Exhibit No. 3, which is the D & H size what?           A. Half-inch.

Q. D & H half-inch. Do you not see abrasions on the ends of the two ribs, way over on the ends of the ribs, indicating where they have been jammed into the flex, shiny parts on the ends?

A. I see a marking right in here (indicating), but I don't see it on the lug.

Q. Well, maybe the light isn't too good. It is in the right light for me but it may not be for you. Do you find a shiny part on the edge of the lug indicating where it came in contact with the flex?

A. I can't see that.

Q. You can't. All right. Now I will hand you Plaintiff's Exhibit 18, which is a half-inch accused coupling, and ask you if you do not find abrasive marks all along the surface of the rib.

A. Well, I see the same mark right on here (indicating) as I see on the other.

Q. Yes, but do you not see abrasions on the rib itself all along the surface of the rib.

A. No, I do not. [58]

Q. You do not?

A. My eyes are not too good. I am sorry.

The Court: What do you mean, these things (indicating)?

Mr. Welsh: No. I mean on the rib itself, your Honor, on the very edge of the rib—the very end of it.

The Court: If you will tilt it this way, you will see it. Hold it like that, with the light on it, and

(Testimony of R. J. Horton.)

you can see it. Hold it way from you. No. The other way. It is a little lighter in coloring, but not very noticeable.

The Witness: My eyes are not good enough for that.

Mr. Welsh: Your Honor, this is the accused device, and the abrasions on the surface of the ribs.

The Court: Oh, yes, I see them.

Mr. Welsh: That is all.

The Court: I see them. It is a little lighter.

The Witness: Oh, yes, yes, I see it now.

The Court: And you can see it?

The Witness: In other words, right across there (indicating).

The Court: Corresponding to the same thing right here (indicating).

The Witness: Yes.

The Court: In other words, something has rubbed there.

The Witness: Yes.

The Court: In other words, it doesn't fit in tightly [59] the way grooves would fit it.

Mr. Welsh: That is all.

The Court: All right. Step down.

Call your next witness.

R. S. BERRY

called as a witness on behalf of the plaintiff, being first duly sworn, was examined and testified as follows:

The Clerk: What is your name, please?

The Witness: R. S. Berry.

Direct Examination

Q. (By Mr. Mason): What is your profession, Mr. Berry?

A. I am a patent attorney and attorney at law.

Q. How long have you been a patent attorney?

A. Since 1907.

Q. How long have you been a lawyer?

A. Since 1919.

Q. And has your practice been in Los Angeles all the time?

A. Not altogether. I spent from 1906 to 1913 in San Francisco.

Q. And have you acted as expert in any patent cases?

A. On several occasions. One before his Honor. I believe one of the earliest patent cases that you tried, in connection with a tortilla-manufacturing machine. [60]

The Court: Oh, yes, I remember the tortilla case. I remember they invented an easier way of making a tortilla by saving portions of the dough and throwing it back in.

The Witness: That is right. You have a good memory.

The Court: That is right.

(Testimony of R. S. Berry.)

Q. (By Mr. Mason): You are the attorney who took out the important patent in suit, No. 2,475,322?

A. I am.

Q. Are you familiar with that patent?

A. I did not write the specification or prosecute the application personally, but I am familiar with it.

Q. You have, preparatory to testifying here, restudied it, have you?      A. I have.

Q. Now, are you familiar with the coupling devices that have been offered in evidence here as the plaintiff's devices, being Exhibits 2, 3, 4, and 5, and the defendants' devices, Exhibits 17, 18, 19, and 20?      A. Yes.

Q. And have you examined and measured the conduits which are in evidence as Exhibits 13, 14, 15, and 16?      A. Yes.

Q. Now, have you made any drawings preparatory to testifying here, in order to illustrate your testimony?      A. I have. [61]

Q. And are those the drawings on the board and which have been marked for identification as Exhibits 25, 26, 27, and 28?

(The drawings referred to were marked Plaintiff's Exhibits Nos. 25, 26, 27, and 28 for identification.)

A. Those are the drawings I prepared.

Mr. Welsh: Excuse me. May I interrupt for a moment to get the numbers on those, just so I can identify them?

Thank you.

(Testimony of R. S. Berry.)

Q. (By Mr. Mason): Now, Mr. Berry, by reference to the drawings, will you explain to the court the operation of the plaintiff's coupling, connector devices as shown on those drawings and by the exhibits?

A. You say the operation?

Q. Yes, And in doing so, will you explain how it is possible for those couplings, connector devices to be inserted in the tubing and how it is that they become locked in the tubing?

A. Well, the coupling element in each instance is inserted in the conduit and rotated relative thereto, to bring spaced ribs on the coupling into engagement with the spiral channels in the conduit.

Q. Now, will you mark with some identifying letter on the drawing the ribs to which you have referred?

A. I designate the rib, or one of the ribs, with the [62] letter "A." That rib appears on each of the four sheets of drawings, Exhibits 25, 26, 27, and 28, designated "A". (Witness marking on exhibits.) I am designating the rib on the DH coupling of the plaintiff.

Q. Now, how are those ribs arranged on the coupling?

A. In the DH coupling on Exhibit 25 they extend perpendicular to the longitudinal axis of the coupling, and they are spaced apart on centers one-eighth of an inch.

They extend circumferentially of the coupling approximately 60 degrees with a space of 120 degrees between the approximate ends of the ribs, there



(Testimony of R. S. Berry.)

being two of such ribs on the diametrically opposite sides of the coupling.

The ribs are also arranged so that a pair of them, or the entire group, considered collectively, define what is termed a helical angle. That helical angle varies in the different sizes of the coupling according to its diameter.

On the smaller coupling, designated or referred to as a  $\frac{3}{8}$ -inch coupling, that helical angle, as far as that part is concerned, and all the rest of them, can be measured and should be measured on centers, diametrically opposed centers, taken from either the base or side of the rib, or from the peak or the center of the rib, as the peak of a thread.

On the  $\frac{3}{8}$ -inch coupling, the angle taken at the base I have designated here as 19 degrees according to my reading of the protractor, and the one from the ridges is 15 degrees. [63]

Now, in the coupling designated as a  $\frac{1}{2}$ -inch coupling, on Exhibit No. 26, the base helical angle is 14 degrees, while the peak angle is 12 degrees.

In the  $\frac{3}{4}$ -inch coupling, Exhibit No. 27, the base angle is 10 degrees, while that of the peak is 9 degrees.

In Exhibit No. 28, the base angle is 12 degrees, while that at the peak is 10 degrees.

Those degrees represent the general helical angle of the ribs in relation to each other.

And my calculations here I believe to be reasonably accurate because I spent a lot of time to de-



(Testimony of R. S. Berry.)

termine them. They might fluctuate perhaps the thickness of a pencil line, but not materially.

Q. Now, in each of those cases when you measured the conduit, what did you find to be the helical angle defined by the convolution of the conduit?

A. In the conduit on Exhibit No. 25, ordinarily designated as a  $\frac{3}{8}$ -inch conduit, the helical angle is 12 degrees, which, in comparison with that of the  $\frac{3}{8}$ -inch coupling of either 15 degrees or 19 degrees, of course, is much less.

The helical angle of a half-inch conduit on Exhibit 26 is 8 degrees as compared with the larger helical angle of either 12 or 14 degrees of the associated coupling.

The helical angle of the  $\frac{3}{4}$ -inch conduit of Exhibit 27 is 8.5 degrees as compared with either 9 or 10 degrees of its [64] associated coupling.

In the 1-inch conduit of Exhibit 28, the helical angle is 9 degrees as compared with either 10 or 12 degrees of the 1-inch DH coupling.

Q. Now, in arriving at the helical angles of the various conduits shown on Exhibits 25 to 28, inclusive, have you measured the conduits which have been offered in evidence as Exhibits 13, 14, 15, and 16, respectively?

A. I have, and with the aid of a mirror and calipers.

Q. Now, what is the purpose of the spacing of the ribs which you have described relative to the helical angle formed by the convolutions of the conduit?

(Testimony of R. S. Berry.)

A. It is manifestly for the purpose of effecting a wedge engagement between the ribs of the coupling and the internal channels of the conduit.

Q. What is the purpose of making the ribs 60 degrees about the circumference of the collar as distinguished from extending them entirely around the circumference?

A. That is to permit the spirals, the internal spirals of the conduit, to pass from one side of a rib to another, of an opposite rib. Without that gap or an adequate gap between the ends of the ribs, it would be impossible to mesh the coupling with the conduit. It is the same or analogous to attempting to mesh the threads of a bolt of one pitch with the threads of another of another pitch, but, by providing this [65] break or gap or space between the ends of the ribs, the screw engagement is effected by the one rib passing across a spiral of the conduit into an adjacent channel.

Q. Now, in order to obtain the free entry of the coupling into the conduit and then have it become locked in the manner which has been demonstrated here, what are the elements shown in those drawings which are essential to that operation?

A. The relative spacing of the ribs, plus their greater helical angle relative to the helical angle of the spirals of the conduit.

Q. Now will you refer to the illustrations of the accused devices on those various drawings, Exhibits 25 to 28, inclusive, and state what if any differences you find as between the devices that plaintiff illus-

(Testimony of R. S. Berry.)

trated on those drawings and the devices of the defendants?

A. In each instance the relative spacing of the ribs and the relative helical angles and those of the respective conduits are identical to those of the D & H Company.

Q. When you say the D & H, you refer to the plaintiff?

A. Yes, D & H is the plaintiff's, and we have designated the defendants' as the MS coupling. That is answering it generally. If you wish, I can take each one as shown on each drawing.

Q. Please take each one on each drawing, will you? [66]

A. On Exhibit No. 25, a  $\frac{3}{8}$ -inch coupling, the spacing of the ribs on centers is one-eighth of an inch. They extend 60 degrees around the circumference of the coupling.

The helical angle at the base of opposite ribs is 19 degrees, and at their peak is 15 degrees, as compared with the 12-degree helical angle of the conduit.

In Exhibit 26, the  $\frac{1}{2}$ -inch——

Q. Just a moment. Before you leave that, are those the same dimensions you have described for the plaintiff's coupling, the  $\frac{3}{8}$ -inch size?

A. Yes, sir, correct.

The same is true as to Exhibit 26, that the dimensions of the MS coupling are identical to those of the DH coupling, the ribs being spaced apart on

(Testimony of R. S. Berry.)

centers longitudinally of the coupling at  $5/32$  of an inch on centers.

Their helical angle is 14 degrees at the base and 12 degrees at the peak, as compared with the 8-degree helical angle of the conduit.

On Exhibit 27, the spacings of the MS coupling are  $5/32$  of an inch on centers, with a 10-degree helical angle at the base and a 9-degree helical angle at the peak, as compared with the 8.5-degree helical angle of the conduit, which is identical to that of the  $3/4$ -inch DH coupling of the plaintiff.

On Exhibit 28, the 1-inch MS coupling, the ribs are spaced  $13/64$  of an inch on centers. They extend 60 degrees [67] around the circumference of the coupling, as is also true—and I did not mention that before—as to the extension, 60-degree extension, I believe, of the  $1/2$ -inch and the  $3/4$ -inch couplings. Their helical angle is 12 degrees at the base and 10 degrees at the peak, corresponding to that helical angle or the helical angle of the 1-inch DH coupling relative to the 9-degree helical angle of the conduit.

Q. Well, is this a correct statement or summary of your testimony about the spacing of the ribs, that in each of the defendants' devices and in each of the plaintiff's devices you find that the spacing of the ribs is such that they define a spiral having a greater helical angle than that formed by the convolutions of the conduit?

Mr. Welsh: I object to that as calling for a con-

(Testimony of R. S. Berry.)

clusion of the witness, your Honor. I think the evidence speaks for itself.

The Court: I never allow an expert to answer that question.

The Witness: Thanks.

The Court: And Mr. Berry has been here, as he said. Ever since I became a judge, I drew the line on that, and I even gave a lecture which was published both in the Patent Journal and in the Bar Association Journal, to the effect that if we let him answer that question, we are asking him to decide what I am to decide. [68]

Mr. Mason: I recall that, your Honor.

The Court: And even if he were a scientist, I do not allow it, but a man who is a patent lawyer is an advocate. He is not a scientist. He is defending the device. The more he sticks to facts, the more likely I am to follow him, and when he gets into the realm of opinion he is invading my province.

Q. (By Mr. Mason): Mr. Berry, in the devices of Exhibits 26, 27, and 28, on the drawings I notice that you show the ribs as being disposed at a slightly lesser angle to the major axis of the coupling than a right angle. Does that have any difference in the function of the devices?

Mr. Welsh: I object to that, your Honor, as calling for a conclusion of the witness; That is for the court to determine, whether or not that angle makes any difference in the means of operation of the two devices.

The Court: I think he can describe them and let

(Testimony of R. S. Berry.)

me draw the inference as to whether their function is the same or not.

The Witness: You are referring now, I take it, to the defendants' MS coupling?

The Court: Yes, just describe how it functions in contrast to the plaintiff's device.

Mr. Mason: To make it clear, please point out that on Exhibit 26, for instance, on the plaintiff's device. [69]

The Witness: No. The defendants'. Pardon me. On the plaintiff's, right.

Q. (By Mr. Mason): You have the ribs disposed strictly at a right angle to the longitudinal axis of the coupling? A. Correct.

Q. Whereas, on the defendants' device there is a 3.5-degree difference? A. That is right.

In each of the MS couplings of the defendants, on Exhibits 26, 27, and 28, the ribs extend at slightly angular relationship to the longitudinal axis of the coupling.

On Exhibit 26 that angle is approximately 3.5 degrees.

In Exhibit 27, on the  $\frac{3}{4}$ -inch conduit, at a 2-degree or approximately; and in Exhibit 28 it is approximately 3 degrees.

Now, those degrees are relative to the perpendicular struck from the longitudinal axis.

Mr. Welsh: I think the witness misstated. On Exhibit 28, on my copy, it indicates 5 degrees.

The Witness: Pardon me?



Testimony of R. S. Berry.)

Mr. Welsh: On my copy of Exhibit 28 it says 5 degrees.

The Witness: 5 degrees, that is right. I stand to be corrected.

Now, I have found by demonstration here where I have had these exhibits in my possession for the past week and put [70] them together and took them apart time and time again, that there is no difference in the action, the reason for it being that the angular relation of the rib does not alter its helical angle struck from centers.

The only possible difference in the action—the mode of operation is identical, but in the action, by reason of the rib being at an angle, its leading edge, as compared with one that is perpendicular, could possibly meet with the wall of a convolution of the spiral, let us say, a moment sooner, quicker.

The Court: That is true. Let us stop right there.

In other words, that would be true of almost any kind of a spiral?

The Witness: That is right.

The Court: In other words, when you thread, you of necessity thread an angle, isn't that true?

The Witness: But in a thread——

The Court: In an ordinary thread.

The Witness: In an ordinary thread the pitch is at an angle.

The Court: And what this inventor claimed and what he exhibited here is a departure from the ordinary thing, whereby, by spacing these——

The Witness: Ribs.

(Testimony of R. S. Berry.)

The Court: ———ribs, by spacing these ribs, he caught [71] every alternate one instead of a straight one.

The Witness: That is right.

The Court: And he demonstrated it on Figure 8.

The Witness: That is right.

The Court: In other words, he claimed a departure in plaintiff's coupling?

The Witness: That is right.

The Court: As soon as you go back to a tool such as the accused device, you are back in the same kind of situation as you have in an ordinary fitting tool, tube, by taking two pipes and putting them together and fitting them and joining them, isn't that true?

The Witness: I am going to take these, Judge. I think you have a little misconception.

The Court: No, I have not a misconception. I am looking at the disclosure of Figure 8.

The Witness: You are talking about the plaintiff's here?

The Court: The plaintiff's, yes.

The Witness: What I am getting at by testifying is the fact that by tilting this rib slightly across here (indicating) it is not changing the action of that rib.

The Court: That doesn't make any difference, but the only thing he got, the only claim he got is a departure from the ordinary thing. They wouldn't have given him a claim [72] on something which you can create any time by taking a piece of pipe



(Testimony of R. S. Berry.)

and making your own thread with a threading machine.

The Witness: That is right, but may I point out, your Honor, that the claim calls for the rib being substantially perpendicular to the axis of the conduit.

The Court: Yes.

The Witness: And I am presenting the argument here——

The Court: I am glad you call it argument.

The Witness: I call it an argument because it sound like it.

The Court: An angle is not a perpendicular.

The Witness: Well, that is right. But from 2 degrees to 5 degrees, I would say, is substantially perpendicular. As long as it doesn't change the function or the action, the mode of operation becomes the same.

The Court: All right, go ahead.

The Witness: That is what I ascertained here, was the fact that while this angle that we are speaking of now is what we might call the pitch of the ridge of the defendants' device, and that pitch ranges anywhere from 2 to 5 degrees relative to the perpendicular, its action or its function is exactly the same as if it were perpendicular, for the simple reason that it threads into the channel of the conduit in exactly the same way and effects exactly the same engagement.

Q. (By Mr. Mason): And on Exhibit 25 the rib is disposed [73] perpendicular to the major axis

(Testimony of R. S. Berry.)

of the coupling, is it not?      A. That is right.

Q. There is no spiraling or angling there?

The Court: Well, why do you draw the lines at 5 degrees? Supposing he made them at a greater angle than under your interpretation of the claim, anything that you can put in there, no matter whether it follows the teaching of the figures here or whether it is at an angle which engages tightly any kind of thread, would read upon this claim, wouldn't it?

The Witness: Well, no, I don't quite get that picture, your Honor.

The Court: Well, I don't get it either from this line, but I get it from your testimony.

The Witness: What I am trying to get at here is that the angle that we are speaking of now is not the helical angle. It is the angular relationship, the longitudinal length of that rib to the perpendicular, and is not critical.

The Court: That isn't the point. The point is this, that what he is doing is introducing a right angle which is irregular and which, by skipping, as he has demonstrated on Figure 8, is going to catch one of these threads.

The Witness: That is right.

The Court: Which are the ordinary threads.

The Witness: That is right. [74]

The Court: And as soon as he gets back to an angular thread he is in the domain of an ordinary plumber who can fix his pipe, make his threads and couple them together, and doesn't have to worry about any invention.

(Testimony of R. S. Berry.)

The Witness: Yes, that would be true, your Honor, if the angle——

The Court: If my voice is crisp, I might state that I am at the tail end of cold.

The Witness: That would be true, your Honor, if you are referring now to what is known as the helical angle, which would be the pitch of a thread, but this has nothing to do with the pitch of a thread. It is not given that angle in the defendants' device for the purpose of making the spiral thread.

The Court: But the claim says, "said ribs being sequentially disposed in staggered relation along the outer surface of the conduit-engaging portion of said coupling so as to define a spiral having a greater helical angle than the normal helical angle of the convolutions of the conduit."

The Witness: That is right, but that is not the angle that we are talking about.

The Court: What angle are you talking about?

The Witness: May I take one of the exhibits?

The Court: I don't know what you are talking about. I am talking about the claim. You infringe a claim, you do [75] not infringe a description.

The Witness: We want to get on common ground here,——

The Court: All right.

The Witness: ——so we know we are both talking about the same thing and not for the sake of argument.

The Court: Yes.

(Testimony of R. S. Berry.)

The Witness: This is an angle, right across here (indicating), relative to the end of this conduit.

The Court: That is true.

The Witness: All right. Now, that angle continued out across here (indicating) would not convert this into a thread.

The Court: Well, unless they were measured as the other is.

The Witness: As you look at it, it might appear that way, but if you put the instrument on there, you will find that those threads will not meet.

The Court: Well, it doesn't make any difference. Supposing you made a picture of this, it certainly would not correspond with this picture, Figure 8.

The Witness: I will show you what it would do.

The Court: What would it do?

The Witness: It would show this inclined just a little bit farther over this (indicating), say like that (indicating), but not necessarily. I will mark it with a little red there. It just inclines it but it doesn't change the relative [76] spiral arrangement relative to the spiral of the conduit at all.

The Court: Then, of course, this last portion——

The Witness: Yes, that refers to the helical angle.

The Court: The helical angle?

The Witness: That is right.

The Court: And that would not apply to the accused device at all?

The Witness: Oh, yes.

The Court: How would it apply?

(Testimony of R. S. Berry.)

The Witness: That helical angle is exactly the same.

The Court: Why?

The Witness: Because the helical angle is measured from the centers diametrically opposite, not from the ends.

If you measure this from the ends here, you get one angle right across here (indicating), see.

The Court: Yes.

The Witness: The actual helical angle is measured from the center of the rib here to the center of the rib over here (indicating), and that is not on a spiral. It looks like a—this is what we call a calculus variation.

The Court: You can't continue this line direct without its continuing to have a deviation at an angle, if you did it a thousand times.

The Witness: Well, let me see if I can make it clear [77] here. If I were to lay a ruler across the lower edge of this here (indicating) and carry it around here (indicating), it wouldn't line up with this (indicating). In other words, there would be an angle here.

In other words, this isn't what we commonly call an interrupted thread. We have interrupted threads in the art here, but the defendants' device is not an interrupted thread, because this rib does not extend upon a true spiral with relation to this rib here (indicating). If one of these ribs was continued on around, it would probably extend alongside the other one, but it would not be in spiral

(Testimony of R. S. Berry.)

alignment with it. In that respect it is not a spiral like a screw thread.

The Court: Go ahead. I was just sending for something to measure it.

Q. (By Mr. Mason): Will you point out on each of these drawings the line which you have used to denote the helical angle?

A. In Exhibit 25, on the  $\frac{3}{8}$ -inch DH coupling and also on the  $\frac{3}{8}$ -inch MS coupling, it is designated by broken lines here. I will indicate them by the capital letter "B" in both instances, because they are the same (marking on exhibit).

While you did not ask it, the same is true in each of the other exhibits, Nos. 26, 27, and 28, the broken lines, [78] they go diagonally from the base and the peak respectively of the ribs.

Now, those broken lines are taken on centers at diametrically opposite sides of the cylinder.

Q. Now, let me ask you this. You will notice that in the plaintiff's coupling the ribs are disposed at right angles to the major axis of the coupling, whereas, in the accused coupling, it is about at a 3.5 lesser angle. Does that make any difference in determining the spiral, the helical angle to which you have referred? A. Not at all.

Q. If those ribs in either the plaintiff's or the defendants' devices were spaced apart a distance so as to define a helical angle which was the same as that of the conduit, would it effect any binding action?

A. No more than just the normal surface fric-

(Testimony of R. S. Berry.)

tion. There would be no so-called binding or locking action as is demonstrated here.

Q. If you were to continue the ribs around the full circumference in the form of a spiral, and the spiral was greater than the helical angle of the conduit, could you insert the connector into the conduit?

A. They would not intermesh. You could not insert the coupling into the spiral, if I get you correctly.

Q. So that, in order to get a helical angle which is [79] greater than that of the conduit, you would have to make the ribs shorter than the full circumference of the connector?

A. That is right. In other words, spaced apart at their ends.

Mr. Mason: That is all. You may cross-examine.

The Court: Just a minute before you continue here. Let me see the device, the accused device.

The Witness: That is it.

The Court: All right. Here is a straight-edge, a measure, a small ruler, a 6-inch ruler. I wish you would measure the distances on this device to the edge on both sides, and tell me the distances, and then I will ask you a question how in the law of mathematics you can call this substantially a right angle. I tell you what the final question is so you will know what I am driving at.

(The witness illustrates.)

The Court: That may not be——



(Testimony of R. S. Berry.)

The Witness: That is pretty close, your Honor.

The Court: What is that?

The Witness: This is  $\frac{3}{16}$  of an inch.

The Court: All right, and the other one?

The Witness: On the other one, I will reverse it, and we get approximately a little over  $\frac{1}{4}$ -inch, I would say that it is about  $\frac{9}{32}$ -inch.

The Court: And would you say that that is put there at [80] substantially a right angle?

The Witness: Well, that word "substantially" has a certain amount of latitude.

The Court: No. I know what "substantially" means. "Substantially" means in effect.

The Witness: In effect, yes.

The Court: "Substantially" may allow for a variation of .001 per cent.

The Witness: That is right.

The Court: All right.

The Witness: And the effect is the same.

The Court: I am not talking about the effect. Would you say that that is substantially at a right angle?

The Witness: I would say that that is substantially at a right angle.

The Court: That is in your language, not in mine. Not in mine, sir.

All right, go ahead.

### Cross Examination

Q. (By Mr. Welsh): Mr. Berry, did you ever conduct any experiment to determine exactly what

(Testimony of R. S. Berry.)

happens to these ribs on the inside of the conduit and the result from pressure?

A. Only by hand, as by screwing them together and separating them. [81]

Q. Did you ever in doing that notice that on the patented device the markings are on the edge, and on the accused device the markings are all on the surface? Did you ever notice that?

A. In the particular exhibit that we have in front of us here, those have been screwed out and in, time and time again, and naturally will leave some markings on it.

Q. Wait a minute. The accused devices have been screwed in just as many times as the patented device.

A. Yes. I worked them, I worked them both.

Q. You hadn't particularly noticed that, then?

A. Surely.

Q. Oh, you have?           A. Yes.

Q. Did you ever dye any of these devices and then notice it?

A. I contemplated using prussian blue on them but didn't get around to it. I didn't have time. I didn't.

The Court: You can screw them together and, by sawing them across, find out where they meet?

Mr. Welch: We have some evidence on that, your Honor. There is a Jake device that is in evidence here, and I don't want to put this in evidence. There is another Jake device that is in evidence.

The Court: I don't want any more exhibits.

(Testimony of R. S. Berry.)

Q. (By Mr. Welsh): Now, looking at this Jake device here, you have a device that has continued threads that are presumably meant to mesh with the convolutions of the conduit, is that correct, sir?

A. That is right.

Q. Now, in this case, in that Jake device, this helical angle is identical with the angle of the so-called rib, isn't it?

A. That is right. Wait a minute. You said "rib."

Q. Well, thread? It is a matter of terminology. Let us say protuberance.

A. I just don't want to be mistaken here in my answer. That does not have the same angle as the ribs of the exhibits here.

Q. No, I appreciate it doesn't have the same.

A. But it does have the same angle as the convolutions of the conduit.

Q. Yes, and the helical angle of these threads or protuberances is the same as the angle of the protuberance, is it not? A. No.

Q. Well, wouldn't it be just a continuation? For instance, supposing I were to mutilate this Jake connector, then you would have something similar to what you have here, in the sense that you would have an interrupted thread; [83] wouldn't the angle of the protuberance be the same as the helical angle?

A. Oh, yes, in so far as these particular threads are concerned, but not in connection with those.

Q. Oh, no, they would not be the same as these.

(Testimony of R. S. Berry.)

A. We had one over there where I had Mr. Horton sever those threads. I demonstrated that.

Q. All right.

A. I did that very thing, sir. I had those threads mutilated, and it didn't change the operation a bit in so far as the operation of the Jake connector is concerned.

Q. My only point is that when you do that, then the angle of this protuberance of the Jake connector is the same as the helical angle of the Jake connector.

A. That is right, I will agree with you.

Q. Yes, so that the angle at which this is disposed has something to do with the helical angle, does it not?

A. Well, it is a continuation.

Q. Surely.

A. It makes a screw and it is in spiral alignment.

Mr. Welsh: That is all. I don't have any more questions.

The Court: Do you have any other questions?

Mr. Mason: That is all.

The Court: I think we will take a short recess.

(Recess.)

The Court: All right. Call your next witness.

Mr. Mason: I offer in evidence Plaintiff's Exhibits 24 to 28, for the purpose of illustrating the testimony of Mr. Berry.

The Court: They may be received.

The Clerk: Exhibit No. 24 is already in evidence.

So there will be Exhibits 25, 26, 27, and 28 in evidence.

The Court: All right.

(The drawings referred to, marked Plaintiff's Exhibits Nos. 25, 26, 27, and 28, respectively, were received in evidence.)

[See Book of Exhibits.]

Mr. Mason: I wish to place in the stipulation that we have arrived at, that the devices of the defendants which have been placed in evidence were made and sold by the defendants subsequent to the issuance of the patent in suit and prior to the institution of this action, that is, those devices or equivalent devices.

Mr. Welsh: With one exception which I discovered after speaking with you, Mr. Mason. The  $\frac{3}{8}$ -inch, the very small one, was made but was not sold. I have in my possession and will introduce it, or counsel for plaintiff may, a  $\frac{3}{8}$ -inch device which was sold subsequent to the patent and prior to the litigation. The one that is in evidence was experimental and was not sold on the market.

Do you want to substitute this or put this in evidence? [85]

Mr. Mason: No. I do not.

I will call Mr. Friedman.

Mr. Welsh: With the exception of that, your Honor, the stipulation stands as to all other exhibits.

The Court: All right.

SAMUEL W. FRIEDMAN

called as an adverse witness by the plaintiff, being first duly sworn, testified as follows:

The Clerk: What is the name, please?

The Witness: Samuel W. Friedman.

Direct Examination

Q. (By Mr. Mason): Mr. Friedman, I show you Exhibit No. 17 and ask you if you made or sold any of those subsequent to July 5, 1949.

A. No. We did not manufacture or make them prior to that time.

Q. I said, subsequent to July 5, 1949, did you make or sell any devices as shown by Exhibit No. 17?

A. I said we did not manufacture them in that time.

Q. Well, did you sell any?

A. No. We did not make them. We didn't sell them.

Q. When did you make and sell a device of Exhibit 17?

Mr. Welsh: I object to that as a compound question, your Honor. He is asking him two questions.

Q. (By Mr. Mason): When did you first make a device of [86] Exhibit 17?

A. Sometime in '51.

Q. And when did you first sell a device as shown in Exhibit 17?

A. That was made several months later.

Q. Several months after '50, later?

A. In 1951.

(Testimony of Samuel W. Friedman.)

Mr. Welsh: Will you read the question and answer?

(Record read.)

Mr. Welsh: That was not responsive, that it was made several months later. The question was, When did you first sell a device such as in Plaintiff's Exhibit 17?

The Witness: Sometime in '51.

Mr. Mason: Then do you wish to enter into the stipulation that I proposed with respect to this Exhibit 17, counsel?

Mr. Welsh: Well, I would like to ask just a few questions, just to make sure that I have the witness' testimony.

#### Cross Examination

Q. (By Mr. Welsh): Mr. Friedman, Exhibit No. 17, did you ever sell that device or one just like it?

A. One just like it or similar to it.

Q. Now, I show you a device which is not marked as an exhibit, and ask you if that is the same as Exhibit No. 17, or if that is a subsequent product. [87]

A. Well, of this first one, Exhibit 17, we originally made samples, around approximately a hundred, and passed them out.

Q. Did you sell them?

A. We did not sell them. We gave them out as samples. Then we came out with this one later and we did sell this one in my hand.

Q. Now, the question counsel asked you is



(Testimony of Samuel W. Friedman.)

whether you sold, which means you got compensation for their sale.

A. No, I did not, not Exhibit No. 17.

The Court: All right. Are you satisfied with the record, or what?

Mr. Welsh: I am satisfied with it, yes, sir.

The Court: I do not think it is of any great importance at this stage of the case.

Mr. Welsh: Well, we have one that was sold.

The Court: All right.

Mr. Mason: Well, if your Honor please, this one differs from the others of the defendants' devices in that the ribs are disposed normally to the major axis identical with the patent, whereas the others have the slight—

The Court: Well, if he made them experimentally and then threw them away and did not use them, there is no infringement. A man may putter around, but if he doesn't put them in commerce, he doesn't do you any harm. [88]

Mr. Mason: He has testified that he made them and handed them out as samples.

The Court: As samples. That is not a sale. Counsel, I will let you argue the effect later, if you want to, but I think the testimony is uncontradicted.

All right. Is there anything further with this witness?

Mr. Mason: That is all with this witness.

The Court: All right. Step down.

Mr. Mason: Mrs. Horton.

The Court: What is the object of putting Mrs.

Horton on? I assume that most of her testimony is going to be along the same lines. What is the object of putting her on?

Mr. Mason: There was some mention this morning of marking some of the earlier devices with the serial number of the patent application instead of the patent number.

The Court: Let me take a look at it. I think I will dispose of that. The man has a right to say that he has a patent application pending, number so and so, without being charged with fraud, and there is no charge of fraud in securing it. I can dispose of that very quickly. Let me see what it says.

Mr. Mason: There is a letter from Mr. Stratton to my client, the plaintiff, and their reply dated March, 1950.

The Court: Well, where is the first? What is this?

Mr. Welsh: That is reply to the letter underneath, [89] your Honor.

The Court: What has this got to do with this lawsuit?

Mr. Welsh: Well, I don't think at this stage of the game it has anything to do with it.

The Court: All right. Then I will sustain the objection.

I will also say that for a claimant to give the patent application number on a device before a patent is issued is perfectly legitimate. In fact, it shows good faith, because, under the law, he is required merely to say "Patent pending." By saying "Patent pending" and giving the number, he allows

the world to know that he has an application pending which has that number, and, instead of showing bad faith, it shows good faith.

Furthermore, even if a man made a mistake by giving a patent application number instead of a patent number, it would not be a defense, and even if you pleaded the defense of unclean hands, it wouldn't be unclean hands.

So I am not interested in what you gentlemen, as advocates representing your clients, told them.

If that is all there is to the issue, I will say it is trivial and I would not take it into consideration at all as involving any unclean hands.

Mr. Mason: I just didn't want an inference.

The Court: All right. [90]

Mr. Mason: I think that concludes my case in chief.

The Court: All right.

Mr. Mason: The plaintiff rests.

(Whereupon the plaintiff rested its case in chief.)

The Court: You may put on your proof.

Mr. Welsh: I would like to move for a dismissal at this time, your Honor, on the grounds that the claim of the patent discloses that the ribs must be substantially at right angles, and the evidence shows that the accused device does not have ribs substantially at right angles; the art is old; the claim should be narrowly construed, and we do not believe that a prima facie case has been made.

The Court: The motion is denied. I prefer to

decide this case upon issues of fact rather than upon a motion of this character.

(Whereupon the defendants to maintain the issues on their behalf offered and introduced the following evidence:)

Mr. Welsh: Mr. Friedman, will you please take the stand?

SAMUEL W. FRIEDMAN

called as a witness on behalf of the defendants, having been previously duly sworn, testified as follows:

Direct Examination

Q. (By Mr. Welsh): Will you state your full name, sir?

A. Samuel W. Friedman. [91]

Q. And your business address?

A. 814 East 29th Street.

Q. Are you in any way connected with the defendant M. Stephens Mfg. Company?

A. Yes. I am president.

Q. For how long have you been president?

A. Approximately eight years.

Q. Now, several exhibits were introduced into evidence other than Plaintiff's Exhibit 17 which you testified to before, which are exemplary of devices purportedly made by your concern. That was stipulated to.

Can you tell me when you started your operation, when you started making up those devices?

A. Sometime in about March of 1951.

Q. And have you sold them on the open market since then? A. Yes.

(Testimony of Samuel W. Friedman.)

Q. Now, in manufacturing your device, is your device intended to perform any particular function? In general first.

A. It is used to hold the flex in place into the box.

Q. All right. Can you briefly describe its principle of operation, how it does the job?

A. It is a screwing action, and we screw it into the flex.

Q. And then how does it stay in, how do you keep it [92] from slipping?

A. Well, it is tightened so that the flex hits the shoulder of the connector. That is what holds it.

Q. By "the shoulder" do you mean the top part of the connector?

A. That would be the bottom part of the connector or the shoulder, as it is called.

Q. Before making your device were you familiar with the so-called Hunter patent, which is the Jake device? A. Yes.

Q. Had you seen it in operation and used it?

A. Yes.

Q. Now, the ribs on your device, when you first started manufacturing your device, were your ribs similar to the ones that are in evidence? I think there are some in front of you here. That is another one. Here is one.

Now, this is Plaintiff's Exhibit No. 20. You will notice that the protuberances here, ribs, are somewhat raised. Is that the way they were?

A. That is the way we made them originally.

(Testimony of Samuel W. Friedman.)

Q. And for what purpose?

A. They got a better grip.

Mr. Mason: Is that the Jake device?

The Witness: No, no, sir. That is the accused device.

The Court: Oh, the accused device. It is difficult to [93] keep track of them, and that is why I want to know what you are talking about. All right. Go ahead.

Q. (By Mr. Welsh): Do you know of your own knowledge how many degrees, if any, off the horizontal the ribs on your device are disposed?

A. About  $31\frac{1}{2}$  degrees off the horizontal.

Q. And does that as a matter of practice make for easy fitting and easy usage?

A. To our knowledge. To the best of our knowledge.

Q. And you have always marked yours with a distinctive marking, have you?

A. You must, according to Underwriters. All items that are Underwriters-approved must have identification. We have.

Q. And that is with the letters "MS", is that right?

A. That is correct.

Q. It has been testified to, but I ask you if this is true, that the coupling is made of zinc, whereas the flex is made of steel, is that right?

A. That is correct.

Q. And I assume that steel is harder than zinc.

A. That is correct.

Q. What effect, then, does it have on the coup-

(Testimony of Samuel W. Friedman.)

ing or on the steel, if any, when you screw in your device?

A. Well, if you would have any rough edges on your [94] connector when you screw it in, it will take them off, it will take off those rough marks, off of the zinc. The steel is stronger.

Q. You mean it would have the effect of rubbing some of the metal off of the coupler, is that right?

A. That is right.

Mr. Welsh: Pardon me for a moment.

The Court: All right.

Q. (By Mr. Welsh): Then, since the metal of the coupler is softer than the metal of the steel, would the coupler ream out the flex?

A. No, sir. It couldn't ream out the flex. The flex would ream the connector, if it had those rough parts on it, as it is turned, as it is screwed in, and when you take it off, because the flex is stronger. A lot of times in die-casting they have unfinished parts.

Q. In the plaintiff's patent he states that his device is for the purpose of twisting, in effect, the twisting of the metal of the conduit. Is that the effect that your connector has in the conduit?

A. Ours has just the reverse.

Q. What do you mean by that?

A. His connects and jams. It pushes it together, and ours pulls it apart.

Q. Your pushes it apart? [95]

A. That is right, from behind.

Q. Now, then, if you had flexible cylinders and



(Testimony of Samuel W. Friedman.)

connected their heads up and pushed toward the outer edges, that is the effect?

A. That is right.

Q. And that is why you have the high protuberances?

A. That is the reason for them.

Q. Would it be a fair statement, to paraphrase what you have said, to say that while theirs stretches lengthwise, yours expands?

A. That is correct.

Q. Now, at my request did you bring with you a junction box, a piece of flex, and a Jake connector?

A. That is correct.

Q. And did you put those together?

A. I did.

Q. I hand you this piece of metal and ask you if that is the junction box, the Jake connector, and the flex.

A. That is correct.

Q. Now, would you please take it apart and put it back together for the benefit of the court? That is the Jake or Hunter patent.

A. May I use their pliers?

The Court: Yes.

Mr. Welsh: Could we borrow your pliers? [96]

Mr. Mason: Yes.

Mr. Welsh: This is the prior art, your Honor.

(The witness illustrates.)

The Witness: You better take it.

Mr. R. J. Horton: My hands are slippery. I will get the other pliers. There is a certain way on that. There is a little trick to it, I will assure you.

Testimony of Samuel W. Friedman.)

The Court: All right, let us have the other pliers.

(Mr. Horton disassembles device.)

Mr. Horton: This is the little trick.

The Court: Let us not take the time to show little tricks. You can show them later.

Q. (By Mr. Welsh): Now, that is the Jake or Hunter patent, is that correct?

A. That is correct.

The Court: All right.

Q. (By Mr. Welsh): Now, will you assemble it together with the junction box, for the purpose of illustration?

(The witness illustrates.)

The Court: All right. Go ahead.

Mr. Welsh: I would like to introduce that into evidence.

The Court: It may be received.

The Clerk: Defendants' Exhibit B in evidence.

(The apparatus referred to, marked Defendants' Exhibit B, was received in evidence.) [97]

Mr. Mason: I object to it on the ground this has not been properly proved, your Honor, if it is offered as a prior use or if it is offered as being exemplary.

The Court: He is demonstrating the prior art.

Mr. Mason: Well, I mean he hasn't qualified this man as an expert to state whether or not that is the Jake patent. He has pleaded the Jake patent as prior art, but he hasn't—

Mr. Welsh: Wait a minute. We have an exhibit.

The Court: Well, we assume that people are

(Testimony of Samuel W. Friedman.)

honest. This bears the name or number—where is it?

Mr. Welsh: It is probably under the coupler, your Honor.

The Witness: No. It is on top. It says "Jake" on it.

The Court: What?

The Witness: May I show it to you?

The Court: It hasn't got that number.

The Witness: Yes, it is right here. It says right on there "Jake," that is, it says a "Jake connector."

The Court: Yes, but it doesn't have the name or number of the patent. If it is the Hunter patent, the number isn't on it.

Mr. Welsh: Well, the Jake is in evidence. They can compare it.

The Court: All right, let us take the one that is admittedly in evidence, so there won't be any question.

Mr. Welsh: Does counsel make any contention that that [98] isn't a Jake?

The Court: He says he doesn't know. It is marked "Jake."

Let us use theirs. That is the same, "Cat BC-050." All right.

Mr. Stratton: The Jake patent—

The Court: All right, gentlemen, you know me, I don't like to get off onto a lot of side details.

Take this Jake patent device, this one that is marked Plaintiff's Exhibit No. 12, and do the operation you did a while ago on this box.

(Testimony of Samuel W. Friedman.)

The Witness: Shall I take off the string?

The Court: No. Well, I will have the clerk take it off and put it back so he can identify it later on.

Mr. Welsh: While this is going on, your Honor, may I introduce into evidence, with counsel's permission, the prior art and the file wrapper?

The Court: All right. The prior art will be received as Defendants' Exhibit C, and the file wrapper will be received as Exhibit D.

(The documents referred to, marked Defendants' Exhibits C and D, respectively, were received in evidence.)

Mr. Welsh: The prior art is Exhibit C, is it, your Honor?

The Court: Yes. And the file wrapper is Exhibit D.

The Witness: All I am doing is inserting the connector [99] into the flex.

The Court: And you are using—what is that, Plaintiff's Exhibit 12?

The Witness: That is correct.

The Court: And you are inserting it into the box which you produced?

The Witness: The junction box, which is the normal use of it.

The Court: All right. We are used to talking for the record and you are not, you see.

The Witness: (Illustrating) There you are, sir.

The Court: All right.

Mr. Welsh: Now, we could demonstrate how it is opened, although that has already been done, but

(Testimony of Samuel W. Friedman.)

we could demonstrate how it is opened up and whether it is necessary to take pliers to do it.

The Court: Well, go ahead.

Q. (By Mr. Welsh): Will you take the exhibit apart?

A. Well, you use pliers when you tighten this, no matter whether you use his or anyone else's, because when they test it—I can loosen this by hand, but if I had the pliers I could tighten it so I couldn't take it off. I can take it off over here, off the nut.

Q. Now, can you take it off of the flex?

A. No, I can't. [100]

Q. In other words, you would have to use a pliers to take it off the flex?

A. That is correct.

The Court: And the reason for that is that you do not have a correspondence between these grooves such as you would have if they threaded two pieces of pipe and fitted them together, isn't that true?

The Witness: That would be approximately that, I believe.

The Court: I am not a plumber, but I do a little work occasionally around the house. But if you took two pieces of pipe and threaded them——

The Witness: They would have the same action.

The Court: All right. And then, if you tightened them, the chances are that when you tightened them by hand, you could unscrew them by hand, because they are even, isn't that true?

The Witness: Yes.

(Testimony of Samuel W. Friedman.)

The Court: But because these are uneven, they get wedged in such a manner that, in order to unscrew them, you need a stronger instrument than your hand, is that it?

The Witness: Yes, sir.

Mr. Welsh: That is the Jake patent.

The Court: Well, we will restore the parts.

Mr. Welsh: It goes in the junction box first, Judge. [110]

The Court: No. You have demonstrated them. If you are going to separate them now, you are going to take this back and then mark the junction box as your exhibit. And this is No. 12.

The Witness: That is No. 12. They didn't want to use ours.

The Court: This is No. 12.

Mr. Welsh: Very well, sir.

The Court: Which you have used merely on Exhibit E.

Mr. Welsh: On Exhibit E, the junction box.

The Court: Restore that. That is Exhibit 12 that you have in your hand.

Mr. Welsh: No. Leave it together.

The Court: You want it left together?

Mr. Welsh: Yes.

The Clerk: Yes, but I have to——

The Court: You have Exhibit 12 already.

The Clerk: The junction box is already Exhibit B. It is already admitted as B, your Honor.

The Court: All right. I didn't remember that.

(Testimony of Samuel W. Friedman.)

Let us go on, gentlemen. It is getting to 4:00 o'clock.

Mr. Welsh: Just a moment, your Honor.

The Court: Let me ask you this question:

You have continued to sell these devices——

The Witness: Connectors. [102]

The Court: ——connectors, to the present time?

The Witness: Yes, sir.

The Court: All right. I just want to bring us up to date.

Mr. Welsh: Your Honor, we have one more witness that we may use. We don't have him in court.

The Court: That is all right. This man has not been cross examined yet.

Mr. Welsh: That is true, but I just want to explain, in case we should run out of witnesses today, I want the court to know that we have one more witness.

The Court: We will have to come back tomorrow anyhow. We will adjourn at 4:30, no matter what stage we have reached, because I would want to hear your arguments, and I am not going into them tonight. We are not crowded, and if we finish with this witness tonight, we will adjourn then, because Mr. Goodwill, the reporter, has to fly to Fresno tonight to be ready to take over court there tomorrow morning. So we will finish with this witness and then we will take our adjournment until tomorrow morning at the usual time. Then we will complete the testimony and then I will hear whatever arguments you desire to present.



(Testimony of Samuel W. Friedman.)

I have read the memoranda you have filed and I am familiar with the positions that both of you take. By eliminating unfair competition it is reduced to a simple issue [103] as to whether there is infringement.

All right.

Mr. Welsh: No further questions.

The Court: All right. Go ahead, Mr. Mason.

Cross Examination

Q. (By Mr. Mason): Mr. Friedman, are you familiar with the Underwriters' rules?

A. Pertaining to what, sir?

Q. To this flexible tubing.

A. To the extent only that there are allowances of so much one way or another.

Q. Well, you know, do you not, that this piece of tubing on which the Jake connector has been inserted, Exhibit 12, is an undersized piece of tubing?

A. It is what, sir?

Q. An undersized piece of tubing.

A. It is not undersized. That was standard flex that was bought at General Electric. Now, we will put in a half-inch connector and see if it is undersized on this other side. (Witness illustrates.) There is nothing undersized about that, sir.

Q. Are you familiar with the use of the so-called "go and no go" gauge in measuring?

A. No. [104]

Q. You are not? A. Definitely not.

Q. Do you know, Mr. Friedman, what causes

(Testimony of Samuel W. Friedman.)

your connector to lock after it has been inserted in the conduit?

A. Yes, the raise, in the high bumps. The bumps on the connector.

Q. Does what?

A. Causes it to expand.

Q. It causes it to expand by engaging the convolutions?

A. The convolutions of the flex.

Q. And causing the raise to pull apart?

A. To raise them, yes.

Q. Well, in order to raise them up, you have to pull them apart?

A. You raise them first and then it pulls them apart.

Q. So it is a simultaneous operation of raising them and pulling them apart?

Mr. Welsh: That isn't what the witness said.

The Court: Let us not do that, Mr. Welsh, please. What did you say?

The Witness: It raises the flex; in other words, it causes it to go up because of the high bumps on the connector—the size of the bumps.

The Court: All right. Then, as you tighten it——

The Witness: It raises it; that is all it does.

The Court: All right.

Q. (By Mr. Mason): Isn't it a fact that the spacing of the ribs on your device which defines a spiral greater than the helical angle of the convolution of the conduit plays an important part in effecting this raising, as you call it?

Testimony of Samuel W. Friedman.)

The Witness: Would you repeat the question again?

The Court: You dropped your voice, Mr. Mason, so it is difficult for me to hear you.

Did you get the question, Mr. Reporter?

The Reporter: Yes, sir.

(Pending question read.)

A. That would be an assumption on my part.

The Court: Well, if you can't answer it, it is all right.

Q. (By Mr. Mason): You are not an engineer, however? A. No, sir.

The Court: How did you get into this business, in plumbing or what?

The Witness: From the hardware and wall plates and wiring devices.

The Court: All right.

Q. (By Mr. Mason): You had seen the plaintiff's devices before you started making this accused device, had you not? A. Yes. [106]

Mr. Mason: That is all.

The Court: Is there any redirect?

Mr. Welsh: No redirect, your Honor.

The Court: All right. Step down.

Mr. Welsh: May we adjourn now?

The Court: Let me ask you one question. Before we go on, you have a counterclaim of some kind. What is that?

Mr. Welsh: That counterclaim was also for unfair competition.

The Court: I see.

Mr. Welsh: A counterclaim similar to the one that was dismissed.

The Court: Yes.

Mr. Welsh: We are disregarding that. We are not going to put any on.

The Court: You are not going to put any on. That eliminates that.

Very well, gentlemen. We will stage our adjournment until 10:00 o'clock tomorrow morning. [107]

\* \* \* \* \*

Los Angeles, Wednesday, Jan. 6, 1954, 10:00 a.m.

The Court: All right, gentlemen, cause on trial.

Mr. Welsh: I would like to recall Mr. Friedman to the stand for a couple of short questions.

The Clerk: Your Honor, I am not too sure that Exhibits 23 and 24 were actually ordered admitted. I have them marked as admitted. They are two advertisements, and to make certain, I think we should have an order.

The Court: I will make the order now that they may be received.

The Clerk: Very good, your Honor.

#### SAMUEL W. FRIEDMAN

recalled as a witness on behalf of the defendant, having been previously duly sworn, testified further as follows:

#### Direct Examination

Q. (By Mr. Welsh): Mr. Friedman, for how

(Testimony of Samuel W. Friedman.)

long a period of time have you manufactured the accused device?

A. Oh, approximately three years.

The Court: Let me hear that?

The Witness: Approximately, about three years.

The Court: Three years.

The Witness: Close to three years now.

Q. (By Mr. Welsh): During that time have you made any [110] changes in the angle, that is, during the time you have actually been selling them and marketing them commercially, have you made any changes in the angle that the rib makes with the longitudinal axis itself? A. No, sir.

Q. Have you had occasion infrequently or frequently to screw your device into flex of different manufacture?

A. Yes, I have tried them, and test them constantly.

Q. And have you found they enter with ease or with difficulty when you screw them in?

A. With ease.

Q. Assuming you do not tighten them up to the last notch, are they easily removable or not easily removable?

A. They can be removed by hand.

Q. Then from your experience in using and manufacturing these devices, do you have an opinion as to whether or not the helical angle of your device is the same as that of the flex into which it is inserted? A. Approximately the same.

Q. Approximately the same helical angle?

(Testimony of Samuel W. Friedman.)

A. That's right.

Q. Now, have you had an opportunity to examine the prior-art patents which have been introduced into evidence as Defendants' Exhibit C?

A. Yes. [111]

The Court: Now, I will take an extra copy, if you have one.

Mr. Welsh: Yes, sir. I will use the copy myself.

The Court: If he is going to testify to that, I would like one.

Mr. Welsh: I will get you one.

The Court: I will take the exhibit itself.

Mr. Welsh: Your Honor, you can keep this as a working copy.

The Court: All right.

Q. (By Mr. Welsh): Now, referring to the Wilson patent, which is for a threaded coupling, a generic patent for a threaded coupling, have you examined this Wilson patent? A. Yes.

Q. And have you compared it with your own device that you are holding in your hand?

A. Yes.

Q. This is a one-inch coupling, is it not, of yours? A. Yes.

Q. In your opinion, are the threads of the Wilson patent more or less of a degree off the horizontal than yours?

A. They are a less degree.

Mr. Mason: Just a moment. I wish to object to this examination, your Honor, as no foundation has been laid. [112] This man is not an engineer, he

(Testimony of Samuel W. Friedman.)

is not a patent man, and he is using him now supposedly to express an expert opinion.

The Court: As a practical person dealing with structures, I think he can give his opinion by comparing one with the other. Overruled. Go ahead.

Q. (By Mr. Welsh): In other words, then, assuming that yours are  $3\frac{1}{2}$  degrees off the horizontal, it is your opinion that the threads on Wilson are less than  $3\frac{1}{2}$  degrees off the horizontal?

A. That's right.

Q. Now, referring to the——

The Court: While we are talking about the Wilson patent, will you look at Figure 6?

Mr. Welsh: Figure 6?

The Court: It seems to me that that shows more. There is no indication of scale here, but it seems to me that that is more than a 5-degree angle. Or am I wrong?

The Witness: I am trying to locate Figure 6.

The Court: Wait a minute. Yet, it is Figure 6. Figure 6 on sheet 2, the second sheet of the specifications.

Mr. Welsh: You can answer the court's question, whether or not this appears to be greater than 5 degrees.

The Witness: It is hard to say, just by looking——

The Court: I beg pardon?

The Witness: I couldn't answer that one correctly, [113] Judge, because——



(Testimony of Samuel W. Friedman.)

The Court: There is a way of measuring it, isn't there?

The Witness: Yes, there is.

Mr. Welsh: With a protractor.

The Court: All right, so long as you cannot answer it. It does seem to me, though, that that would show 5 degrees on a 180-degree semicircle.

Mr. Mason: Your Honor please, I wish to call attention to the fact that patent drawings are not necessarily to scale.

The Court: Yes, I know.

Mr. Mason: We have to look to the specifications to find any reference to the degrees, if there are any variants from the normal situation.

The Court: Is there anything in the specifications that indicates the angle?

Mr. Mason: No, your Honor.

The Court: All right. Then, if there isn't, we will just forget it.

Mr. Welsh: Now, just for the purpose of clearing up the record, your Honor:

Q. When I asked you the question before about your opinion as to these angles, what figures were you referring to in the Wilson patent?

A. 18. [114]

Q. You mean line 18? A. Yes.

Q. But what figure of it? A. Figure 1.

Q. Line 18 of Figure 1? A. Yes.

The Court: Well, Figure 6 is an enlarged drawing of line 18. That is the reason why I was asking for it. In other words, if you look at Figure 1,

(Testimony of Samuel W. Friedman.)

There does not seem to be any angularity to them at all at 18, but if you look at the enlarged drawing, there is quite an angle. That is why I was asking. You can see the two of them. Look at 18. It is the same 18, you see, and they use the same figure.

Let's go on. Evidently my question does not help to clarify anything. All the specifications say on page 2, line 18, is that the panels, that is, 17 and 19, "have substantially the same width and taper as the gaps 18' between the panels of the pin."

Mr. Welsh: That is right.

The Court: "Thus when the pin is inserted in the wall 17 the panels 18 will readily enter the gaps 19', and the panels 19 will freely enter the gaps 18'."

In other words, the same situation, skipping one.

Mr. Welsh: Yes, that is right.

The Court: All right. [115]

Mr. Welsh: Now, my intention was to ask the witness the same question pertaining to the Jacobi patent. We probably will run into the same difficulty with it, looking into the scale.

The Court: Which is that?

Mr. Welsh: That is the second to the last.

The Court: Jacobi, 1,973,170?

Mr. Welsh: That is correct, sir.

The Court: All right.

Q. (By Mr. Welsh): Now, directing your attention to line 12 of Figure 1, and line 12 of Figure 2, and comparing those threads in the Jacobi Patent No. 1,973,170 with the threads or ribs on your de-

(Testimony of Samuel W. Friedman.)

vice, is it your opinion that the Jacobi threads form a greater or less degree?      A. Less degree.

The Court: The last one is a foreign patent.

Q. (By Mr. Welsh): (Continuing) From the horizontal?      A. From the horizontal.

Q. Than the ribs on your device?

A. That's right.

The Court: There is no enlargement there, so you really cannot tell on the Jacobi.

Mr. Welsh: That is true.

The Court: Wait a minute. Oh, no, this is the British patent. [116]

Mr. Welsh: No further questions.

Mr. Stratton: Wait just a moment.

Mr. Welsh: One further thing, your Honor.

The Court: All right.

Q. (By Mr. Welsh): I show you Plaintiff's Exhibit No. 10, which was described as an adapter, and it evidently adapts the plaintiff's device with a steel conduit that is not a flex conduit. Is one end of this adapter—either end of this adapter—suitable for connection with a junction box?

A. I have never seen it used in that way.

Q. Do you know whether or not it can be used in that way?

A. To the best of my knowledge, it cannot be used in a junction box.

Mr. Welsh: No further questions.

The Court: All right, Mr. Mason.

(Testimony of Samuel W. Friedman.)

Cross Examination

Q. (By Mr. Mason): Mr. Friedman, you testified with reference to the helical angle of the conduit with which your connector has been used. Did you actually measure the helical angle or convolution of the conduit?

A. Yes, we had it measured.

Q. Who did it? [117]

A. We had a die man do it.

Q. And which conduit did you measure?

A. We used several different brands, national brands.

Q. Are you capable of measuring the helical angle of the conduit here in evidence?

A. No, I am not.

Q. Do you know which particular piece of conduit your man measured?

A. I said we used several national brands.

Q. Now, you testified about the Wilson patent and the Jacobi patent. You were going merely from the way these appear to your eye?

A. That is correct.

Q. Only to that extent?

A. That is correct.

Q. You have never measured the drawings of the patents? A. No.

Q. And you are not an engineer?

A. No, I am not.

Q. Nor have you had any experience in the interpretation of patents?

A. Not to any great extent.

(Testimony of Samuel W. Friedman.)

Q. When did you say you started manufacturing these devices? In 1951, was it?

A. Approximately. [118]

Q. Approximately what time in 1951?

A. I believe it was sometime in March.

Q. And prior to that time, isn't it true that you telephoned to Mrs. Horton of the plaintiff corporation and attempted to buy the dies of the plaintiff corporation?

A. I have never called Mrs. Horton at any time, for dies or anything else.

Q. Did you have anyone in your organization call Mrs. Horton?

A. No, definitely not.

Q. Do you know it to be a fact from your experience that if you were to make the spiral of the ribs on your connectors to form a helical angle which is the same as the helical angle formed by the convolutions of the conduit, that you would not obtain a locking action of the device in the conduit?

A. Are you referring to the same type of connector with the same type of spirals?

The Court: Or any kind. He has given you a hypothetical question.

Q. (By Mr. Mason): I said "your connectors." I mean such as those in evidence.

A. How are we to change these?

Q. If you had those ribs on your device with a spiral—to define a spiral having the same helical angle as the [119] helical angle formed by the convolutions of the conduit, don't you know it to

(Testimony of Samuel W. Friedman.)

be a fact that you would not obtain a locking action of the connector in the conduit?

A. Well, if I understand you correctly, as I said yesterday, the way our connector operates is from the point that the flex hits the—we will call this the base of the connector, and by tightening it, it hits the base of it, and that is what tightens it.

Q. Well, you haven't answered my question. Will you repeat the question?

A. Then I don't understand it.

Mr. Mason: Would you repeat the question, Miss Reporter?

(The question referred to was read.)

Mr. Welsh: Do you understand the question?

The Witness: No, I don't.

Mr. Welsh: Would you mind rephrasing it, counsel?

Q. (By Mr. Mason): Taking Exhibit 19, for instance, do you know it to be a fact that if the angle, the helical angle, formed by a line drawn from the center of the top rib, top end rib, to the center of the lower end rib, if that angle were the same as the helical angle of the conduit, isn't it a fact that you would not obtain a locking action of the connector in the conduit?

A. I think you could.

Q. Have you ever tried it? [120]

A. Yes.

Q. Where and when?

A. When we experimented with various connectors.

(Testimony of Samuel W. Friedman.)

Q. Did you conduct the experiment yourself?

A. No, I was in on it.

The Court: Of course, it seems to me that when we talk about the helical angle, we are talking about the obvious, because of necessity the helical angle is merely the angle of the spiral, and if you slant them at the same angle, you see, and don't break them and skip, they would not thread. In other words, it is just as though you took one of those simple threaders that you use around the house. As a matter of fact, we have a large place in Hollywood, where we live, and there is so much plumbing in the yard that many a time we go and rent a threader in order to do pipe work. I don't do it myself, but I have seen it done.

Now, in order to make the parts fit, you have got to thread them in the same manner, and, therefore, whether you thread them horizontally or at an angle, they have to correspond, or otherwise they will not lock. It is like doweling in wood. If you have a doweling in wood, you know you have to have a correspondence between the two pieces. You have to have a correspondence between the male and the female, as the plumbers call it, in order that they may lock.

Now, instead of having them at any angle, you have them [121] horizontal, and then you break and skip, your object is to skip one, and, as your Figure 8 of the patent in suit shows, what you do is to skip one and catch the other through your broken ridge there. So that I do not think that the helical



(Testimony of Samuel W. Friedman.)

angle described in the specification is anything but the obvious.

Mr. Mason: Well, your Honor please, I think that is where we have had some misunderstanding, which I am trying to clear up. We have to keep in mind that you have been describing the conventional manner of threading a female and male part, that you are going to screw together. Of course, when the threads meet, you can unscrew it very easily. It does not have a self-locking effect. However, in this patent—and I think this is a substantial departure—we have a combination of two things.

The Court: Let's not argue the case now.

Mr. Mason: Well, I was trying to answer your Honor's point, and it may help if I explain this at this time.

The Court: Yes.

Mr. Mason: Now, the one feature is that one curve of the threads be staggered with relation to another curve, that is, they are diametrically opposite curves. Now, the helical angle we are referring to in the patent is that angle which you define by measuring from one part of one thread of the lower curve to one part of the corresponding [122] thread of another curve.

Now, we make that greater, the helical angle formed by the convolutions of the conduit. But if you had conventional threads, you would not be able to insert the connector into the conduit. So then, what we call the ribs are made relatively short. That enables you to rotate the connector into

(Testimony of Samuel W. Friedman.)

the conduit, and it is then the differential between the helical angle formed by the spacing of the ribs and the helical angle formed by the convolution of the conduit that causes a self-locking effect.

The Court: You are talking about the helical angle as being something different. "Helical" comes from "helix," and a helix is merely a spiral, and the manner of measuring is probably as old as the Phoenicians, who invented geometry.

Mr. Mason: We are not claiming the helical angle, but the difference between the helical angles.

The Court: But look at your Tiefenbacher patent. If your novelty consists in the helical angle, then that portion of your claim reads on Tiefenbacher, because he demonstrates it right there in the picture, a horizontal screw or fitting that catches the spiral in the way yours catches yours.

Mr. Mason: No, your Honor. You will notice in Tiefenbacher that the spiral formed by the sleeve 14 measures and meets with the spiral formed by the convolutions 13.

Now, in that case you can unscrew it, and it does not [123] have any self-locking effect.

However, what these patentees have discovered is that, by making the angle of one greater than the angle of the other, and then making them relatively short instead of continuous, you can obtain—you can not only insert it into the tube or conduit, but when you get it inserted you have a self-locking effect.

The Court: But you also did that by making

(Testimony of Samuel W. Friedman.)

substantially horizontal protrusions, or whatever you call them, and, therefore, your contribution to the art is limited to that particular thing. In view of the art, you cannot claim anything that will insert in the same, locking it, because your claim is not broad enough to cover that. If you read it that way, then it is in the prior art.

Mr. Mason: If your Honor please, as we shall show by Mr. Berry here——

The Court: I am not interested in hearing Mr. Berry, I think Mr. Berry is an advocate, and I think this is a simple thing we can work out. I do not want him brought back again. It is not a misunderstanding. I understand it very well, what you are driving at.

Mr. Mason: The point I want to make is that in none of the prior art is there any showing of the threads of the male member which would correspond to the connector, nor is there any case where there are threads forming a helical angle [124] greater than that of the female member into which it is to be threaded, the female member in this case being the conduit.

The Court: All right. That is argument. Let's get through with the witness.

Mr. Mason: That is all of this witness.

The Court: All right. Step down.

(Witness excused.)

Mr. Welsh: The defendant rests, your Honor.

The Court: Will you give me the file wrapper?

Mr. Mason: I would like to recall Mr. Horton if your Honor please.

The Court: All right.

### R. J. HORTON

recalled as a witness on behalf of the plaintiff, having been previously duly sworn, testified further as follows:

#### Direct Examination

Q. (By Mr. Mason): Mr. Horton, I show you Exhibit 17, which is one of the defendants' connectors which you delivered to me for use as an exhibit in this case, and I will ask you where you obtained that.

A. I got this down at Pryne & Company.

Q. Where is that located?

A. In Pomona. [125]

Q. And when did you obtain that?

A. Approximately ten days ago, or two weeks.

Q. Did you obtain any more at that time?

A. I got, I believe, six.

Q. I have one other of the devices which you have handed me. Is this one you obtained at the same time?

A. No, this is one I got up in San Francisco, I am sure.

Q. When did you obtain that in San Francisco?

A. In October, I believe, of 1951.

The Court: What was the year?

The Witness: October of 1951. I believe it was

(Testimony of R. J. Horton.)

October. It could possibly have been in November, but it was in '51.

Q. (By Mr. Mason): Now, from whom did you obtain it in San Francisco?

A. The California Electric.

Mr. Mason: I would like to offer this in evidence, your Honor.

The Clerk: Is this admitted, your Honor?

The Court: It may be received.

The Clerk: Plaintiff's Exhibit 29 in evidence.

(The article referred to, marked Plaintiff's Exhibit No. 29, was received in evidence.)

Q. (By Mr. Mason): Now, have you since that time tried to purchase any more devices of the defendant? [126]

A. Yes.

Q. What has been the result of your attempts?

A. I checked at Gough Industries yesterday afternoon.

Q. Where are they located?

A. Down on Second Street, here in Los Angeles.

Q. And what was the result?

A. I found that out of the three fixtures that we opened up——

Q. Were those three electrical fixtures?

A. Electrical fixtures—that they had the same type.

Q. Now, did you purchase one of those fittings?

A. I brought one in, yes. I didn't buy it. He wouldn't sell it. He loaned it to me. But I have two others that I did buy this morning.

(Testimony of R. J. Horton.)

Q. I show you a device which you brought into court and ask you if that is the device to which you refer?      A. Yes, that is.

Q. Now, did you obtain a delivery receipt or invoice, or anything, for that?

A. Yes, my wife has it.

Q. Is this the document (handing to witness)?

A. I have two others in the box. They are still sealed up, from Pryne & Company, that I bought this morning.

Q. Now, will you remove this coupling from the junction box, and let us observe the roots on it?

(The witness did as requested.)

Q. Can you with your eyes discern any angle other than a right angle with reference to the major axis of that device?

A. With my eyes, it says it is straight across.

The Court: Let me see that.

(The object was handed to the court.)

The Court: I don't think you are correct. I think if you would measure it you would find that it is at an angle.

The Witness: I put a very fine measurement to it.

The Court: No. It is very obvious. You can see it without glasses. Take off your glasses and look at it. You know, some of us who wear glasses become glass-bound. I think you will see it is at an angle. You can measure it.

Let's get into this helical-angle business.

The Witness: This isn't angled enough to——

(Testimony of R. J. Horton.)

The Court: But you can see the difference. It is not straight across.

Mr. Mason: I hand you a tool with which you can accurately measure angles, and ask you if you can use this.

The Witness: Yes.

Mr. Welsh: What is the angle?

Mr. Mason: It has an angle of less than one degree.

The Court: I see. Well, it has an angle. I don't know the degree of it. [128]

Mr. Mason: I would say one degree, then.

Mr. Welsh: It looks exactly one degree to me. It may be a matter of vision.

Mr. Mason: Now, I offer this invoice in evidence as plaintiff's next exhibit.

The Court: All right. It may be received.

The Clerk: Plaintiff's Exhibit 30 in evidence.

(The document referred to, marked Plaintiff's Exhibit No. 30, was received in evidence.)

Q. (By Mr. Mason): You stated you purchased other devices. When and where did you purchase those?

A. This morning from the Glendale Wholesale Electric house. I have them there in the boxes.

Q. I hand you a box, and ask you whether that is it.

A. Yes, it is. This box has never been opened.

Q. Will you open that up and remove the connector?

(The witness does as requested.)



(Testimony of R. J. Horton.)

The Witness: Do you want to watch me take it out?

Mr. Welsh: Oh, no. I am sure you will do it right. It comes out pretty easily, doesn't it?

The Witness: That could be in the flex not being the proper size.

Mr. Welsh: This is the one you just took out, in my right hand. That is the same thing.

Q. (By Mr. Mason): Just from a visual inspection, it [129] appears that the lugs on one side have a slight angle, and the lugs on the other side seem to be strictly at right angles. Will you use the instrument here and determine whether or not that is the case?

A. I can get the reading on the short side. I am not familiar enough——

The Court: They are both on an angle. This on one side, this nearer to the edge seems to be a little more inclined.

Mr. Welsh: Here is the plaintiff's device, for comparison purposes, your Honor. It is Exhibit 2.

The Court: That is right.

The Witness: Do you want the reading on that?

Q. (By Mr. Mason): Yes. That seems to be about the same angle—one degree off?

A. A little less than one degree off.

The Court: All right.

Q. (By Mr. Mason): And is this the——

A. The purchasing——

Q. ——the purchasing receipt or invoice for this device?  
A. Yes.

(Testimony of R. J. Horton.)

Mr. Mason: I offer this in evidence as plaintiff's next exhibit.

The Court: All right. It may be received.

The Clerk: Plaintiff's 31 in evidence. [130]

(The document referred to, marked Plaintiff's Exhibit No. 31, was received in evidence.)

Mr. Mason: Is this the one you just took out of there?

The Witness: No, this is mine.

Mr. Mason: Where is the connector you just took out?

Mr. Welsh: There is one here. This is the one that was taken out of the first box. In other words, this is not the one you took off the box that you just opened.

The Witness: This came out of this (indicating)?

Mr. Welsh: Yes.

Mr. Mason: And this just came out of the last one.

Mr. Welsh: Yes.

The Witness: Yes.

Mr. Mason: I offer this in evidence.

The Court: All right. It may be received.

The Clerk: Plaintiff's Exhibit 32.

(The article referred to, marked Plaintiff's Exhibit No. 32, was received in evidence.)

The Witness: This one can go back?

The Court: Yes, anything you brought, unless we take it and tie a tag to it. The rest is yours.

The Witness: This is one we want to send back.

(Testimony of R. J. Horton.)

The Court: It is yours. Whatever we take, we tag. The rest you take back as your own.

Anything further from this witness, gentlemen?

Mr. Mason: Yes, your Honor.

Q. I show you Defendants' Exhibit B, being a junction box in which what has been introduced in evidence as Exhibit 12, as a Jake connector, has been used.

First, I will ask you to examine that conduit and state whether or not that is the length of conduit such as is in accordance with the Underwriters' recommendation.

A. This is not according to specifications.

Q. How do you determine that?

A. By the no-go gauge and the go gauge.

Mr. Welsh: Just a moment. I move to strike that.

The Court: What is that?

The Witness: This is the outfit we use for testing to determine whether your flex is to Underwriters' specifications.

The Court: I am not talking about Underwriters' specifications. Your Underwriters' specifications have nothing to do with this.

The Witness: Your Honor——

The Court: Please don't interfere.

Mr. Mason: You have the Underwriters' specifications.

The Court: I am not interested in the Underwriters' specifications. I do not think they have anything to do with this lawsuit. We are not talk-

(Testimony of R. J. Horton.)

ing about whether they conform or not with the Underwriters' specifications. We are [132] concerned with whether or not this structure violates one of these, and the fact that evades any of the Underwriters' specifications does not mean anything. They are merely certain rules that have been established, and it is like the Good Housekeeping magazine's endorsement of a food product. It is something in the trade that people comply with, but I cannot see what bearing it has upon the lawsuit.

Mr. Mason: It defines what would be a normal piece of flex.

The Court: I am not interested in that. You have not shown me that the Underwriters have any standing in law.

Mr. Mason: They don't have any.

The Court: If you give me State specifications which are required under the Code, all right, but requirements by Underwriters, who are a private concern and who make certain rules which they hope the trade will adopt, do not mean anything.

It reminds me of an old story they tell about George Adams. You probably remember him. He had a suit before one of the judges, and he asked him what it was. He said, "It is a suit to quiet the Title Insurance and Trust Company." In other words, he was basing the suit on the fact that the Title Insurance and Trust Company would not give him title unless he brought suit. The same way with the Underwriters' specifications. They are private

(Testimony of R. J. Horton.)

rules, and I cannot see [133] that it has anything to do with the matter at issue at all.

Mr. Mason: My only purpose, your Honor, was to show this was not a normal piece of flex, of conduit.

The Court: It does not make any difference whether it is normal or abnormal. The question before the court is one simple thing. You see, you prepared the case with the idea of pursuing unfair competition. In unfair competition that might have some bearing, but you dropped that, and you have made no offer on it, and the case is whether there was an infringement of the single claim that was allowed out of the sixteen that you asked.

I will sustain the objection.

Anything further from this witness?

Mr. Welsh: We have no cross examination.

The Court: All right. Step down.

Mr. Mason: Just one more question, your Honor. I had not quite finished.

The Court: All right.

Q. (By Mr. Mason): I will ask you to examine the junction box and the Jake connector you have just looked at, and ask you to state whether or not that is the manner in which a Jake connector is connected to conduit and a junction box.

A. Definitely not.

Q. What are the differences between the normal manner of doing it and the way in which that is connected? [134]

A. To start with, your Jake connector, if you

(Testimony of R. J. Horton.)

use a piece of flex that has been sprung out of shape, as this has been——

Mr. Welsh: I move to strike that as a conclusion of the witness.

The Court: It may be stricken. He is asking a particular question which requires demonstration as to the manner in which it should be connected.

The Witness: Your Honor, to use this connector, you screw it in with the collar on here (indicating).

The Court: Yes.

The Witness: That is what locks your fitting.

The Court: Yes.

The Witness: This merely pulls it down to lock it on there.

The Court: All right.

The Witness: The way this was demonstrated yesterday, with this inside the box, where the locknut goes, and by using trick methods, which was used——

Mr. Welsh: I move to strike that as a conclusion, your Honor, the “trick methods” part.

Mr. Mason: It may be stricken.

The Witness: O.K.

The Court: All right.

The Witness: To use it like it is made to be used, like [135] you use it every day in the factory—I am an electrician by trade, and I understand this business——

Q. (By Mr. Mason): Do I understand it correctly that you use a collar in addition?

A. You use a locknut.

(Testimony of R. J. Horton.)

Q. You use a locknut in addition to the collar?

A. Instead of putting this on the inside, as it was yesterday, and pulling up this so that it rides over the shoulder of this, you can make this locking effect, but you can't—it is not allowed to be used that way, and it is not intended for that way.

The Court: But your original patent that you describe intended to use that, too. You merely abandoned it because you discovered it can be done without it; isn't that true?

The Witness: Your Honor, when I first made my fitting——

The Court: That isn't the point. You were talking about the same thing.

The Witness: It shows the collar, but the collar doesn't play any part in it, in my plans there.

The Court: You are very selective there. You asked a patent for something. Now you are trying to show it was a device for some other use, when your own patent postulated that kind of use.

Mr. Mason: If your Honor please, in prosecuting this——

The Court: I know I am arguing, but it is because he [136] is arguing with me. If he was just a witness, I would not do this.

The Witness: I am trying to explain to you.

The Court: You are not explaining. You are arguing, and you have a competent lawyer here. You are saying it is a trick to do it that way, but it is the very method you sought to patent.



(Testimony of R. J. Horton.)

Mr. Mason: In the patent we show many things that are unnecessary.

The Court: I know, but it is unfair for the man to use the word "trick." If he has abandoned it since, it shows it does not deserve to be called a trick. Now, let's forget it.

You are like all inventors. You have an idea in your head, and you think you know it all.

The Witness: No, sir.

The Court: All right.

Mr. Mason: That is all.

The Court: All right. Step down.

(Witness excused.) [137]

The Court: I said something so far as not wanting Mrs. Horton on the stand, so far as I am concerned, but I notice she is very anxious to testify, because I heard her whispering when her husband was on the stand.

As I told you, I have a very keen sense of hearing, and if my eyesight were as keen as my hearing, I would be in fine shape. I heard her at times muttering things to herself when her husband was testifying.

So if you want to put her back on, or put Mr. Berry back on, it is all right with me. I am merely following the custom which I follow in all cases, not to have repetition, especially as between husband and wife, because usually when one has testified to the facts, the other will merely concur. But if she has anything new, you can call her. I didn't want her to get the impression that I was trying

to tell you or anyone what witnesses to put on or not to put on. All I am doing is to try to save judicial time. [137-A]

Mr. Mason: Yes. All I am saying is she is more familiar with dates than her husband.

The Court: On dates we are all agreed. We have all the dates. And as to any matters of accountancy, and things like that, that is a problem we haven't reached yet. When we reach the problem, where an accounting is ordered, then perhaps her testimony will be needed, because she probably knows those details better than he does. But, as you know, I don't hear any accounting. If I find infringement, then I will send it to a master for an accounting, as is usually the rule. But we will not get to that for a couple of years, because an appeal will probably be filed from the interlocutory decree, and we will merely go through the motion of appointing the master, and then stop him in his tracks until the interlocutory decree is passed on by the higher court.

However, I did not want to keep from the record any additional testimony that she may wish to offer. The same way with Mr. Berry, if you want to add something to what he has stated yesterday.

Mr. Mason: I do.

The Court: All right.

Mr. Mason: And I would like to renew my offer, unless the defendant has dismissed the counterclaim of mismarking. I would like to clear that up as a matter of record.

Mr. Welsh: No, we dismissed that yesterday.

The Court: He said he is making no offer under it.

Mr. Mason: I didn't know you had dismissed it.

The Court: Furthermore, he dismissed it after I made the statement that I didn't think this involves any mismarking, because it is a natural thing for a person to take the number. As a matter of fact, he did more than is necessary. So, in view of that, counsel dismissed it.

So you have dismissed your unfair competition, and he has dismissed his counterclaim, and we have just one question. There has been nothing to attack the validity of the patent, unless there is some argument made on the basis of prior art, so the only problem before us is whether there was infringement.

Now, this is off the record.

(Discussion off the record.)

Mr. Mason: I would like to recall Mr. Berry just briefly, your Honor.

The Court: All right.

### R. S. BERRY

recalled as a witness on behalf of the plaintiff, having been previously duly sworn, testified further as follows:

#### Direct Examination

Q. (By Mr. Mason): Mr. Berry, will you refer to the Wilson patent shown in the prior-art patents? [139]

Mr. Welsh: Which one?

Mr. Mason: The Wilson patent.

(Testimony of R. S. Berry.)

Q. (Continued): And state how that operates?

The Court: Have you got it in front of you?

The Witness: I have.

The Court: Go ahead.

The Witness: I didn't get the end of that question.

Mr. Mason: State how it operates.

The Court: He asked you to answer how it operates.

The Witness: I didn't quite catch it.

The Court: All right.

The Witness: This is a coupling that involves groups of interrupted threads of a male and a female member. The purpose is to insert the male member into the female member until all of the threads of the respective members are aligned, and then by rotating the members relative to each other a partial revolution, all of the threads of each group are collectively intermeshed or interengaged.

Q. (By Mr. Mason): Do the threads of the female member and the male member mate?

A. They are mates. They must necessarily be on corresponding pitches in order to interengage.

Q. There is no difference, then, between the helical angle formed by the threads of the male member and the helical angle formed by the threads of the female member? [140]      A. No.

Q. Now, will you refer to the Jacobi patent and state how it operates?

A. We have here in the Jacobi patent a similar arrangement, except that they provide a lead thread.

(Testimony of R. S. Berry.)

In this case the two members are brought together until the lead thread is brought into position to engage the end thread, so that, by starting the rotation of the two members relative to each other it ensures alignment of one group of threads with the other group of threads.

Q. Did the threads of either of the patents you have described effect a self-locking connection?

A. I didn't catch that.

Q. Did the threads of either of the devices you have described effect a self-locking connection?

Mr. Welsh: That is objected to as calling for a conclusion.

The Court: He is an expert. That is all right.

The Witness: By "self-locking" I take it is meant a gripping action. Obviously, the threads being of corresponding pitch in both cases, if the threads are of close fit, there will be a resistance in tightening the threads as well as in loosening them, as in any screw-thread arrangement, but no such interlocking would occur as compared with the devices in evidence. [141]

Q. (By Mr. Mason): Now, will you refer to the Hunter patent and state how that operates?

A. Did you say "Hunter"?

Q. Hunter.

A. The Hunter patent is based on a conduit coupling of the character of the devices of the plaintiff and defendant in this case. The coupling is formed with screw threads that are continuous

(Testimony of R. S. Berry.)

and having a pitch corresponding to that of the conduit with which they are to be engaged.

The device is designed to effect a clamping action by reason of advancing the conduit on the threads of the coupling until the end convolution of the conduit is brought against an abutment. After having initially made this abutting contact, further screwing of the coupling and conduit relative to each other to advance the conduit on the coupling forces the end convolution to expand, and in expanding it is obviously enlarged and is brought into contact with the surrounding wall.

The action here is to foreshorten the conduit to a slight degree and at the same time expand the end convolution. The gripping action is effected by the expansion of the end convolution against the surrounding wall.

Q. Now, is that the end convolution only, or any other convolutions?

A. I didn't quite catch that.

Q. Does it expand merely the end convolution?

A. Yes, it expands merely the end convolution.

Q. Now, I will ask you to refer to the Horton patent in suit, in which you will observe a collar, denoted by the numeral 8, and ask you to state whether or not that collar functions to perform the purpose of the collar in the Hunter patent.

A. No.

Q. Have you studied the other prior-art patents introduced by the defendants in this case?

A. Yes.

Testimony of R. S. Berry.)

Q. Have you found any of those in which the spiral angle, the helical angle, formed by the ribs or threads of the male member, differs from the helical angle formed by the threads in the female member? A. No.

Mr. Mason: That is all.

Mr. Welsh: We have no cross examination.

The Court: Mr. Berry, I want to ask you one question.

The Witness: With pleasure.

The Court: It is not relating to this, and I did not ask it yesterday because I had not read the file wrapper, which I have now read. Yesterday, while you were being examined, when your attention was called to Figure 2 and Figure 8, which show horizontal, you said that was only one of the embodiments of the invention, and you drew in a little [143] modified ridge in red——

The Witness: Right.

The Court: ——to show that there is no deviation, and that, while you said “horizontal,” it meant substantially horizontal; that it did not mean horizontal, it allowed for modification, as I told you it meant in my language. You remember that?

The Witness: Yes.

The Court: Now, I want to call your attention to the fact that you said you did not write the specifications.

The Witness: The original specifications, no.

The Court: However, you signed all the letters which appear.



(Testimony of R. S. Berry.)

The Witness: That is right.

The Court: Whether you dictated them, or as to the man who wrote them, I am not going to ask.

The Witness: That is correct.

The Court: I want to ask you why, then, after all of them had been rejected, and they had intimated that, while you had sixteen claims, possibly two might be allowable if it were properly reworded, why, then, in accepting that ruling as to all except No. 10, which you insisted should be allowed, and that finally was disallowed, why you said in this letter, this:

“Applicant elects to prosecute claims drawn to [144] the invention as shown in Fig. 2, in the event no generic claims are allowed.”

Why, if Figure 2 was merely one illustration, why did you choose that as a correct representation of your invention without any modification?

The Witness: That is very easily explained, your Honor. That has to do with a question that is known as election of specie. You will notice that the construction in Figure 2, which constitutes the subject matter of the allowed claim, is based upon the coupling where it is applied to a box.

The Court: Yes.

The Witness: The construction shown in Figure 8 is another application of the same idea to a coupling which is used in joining the two conduits together.

Now, as the application was filed, claims were

(Testimony of R. S. Berry.)

drawn specifically as to each application of the idea.

The Court: Yes.

The Witness: Now, the patent was denied, or the groups of claims on the specie, because one of them recited the terminal box, while the other recited the coupling.

Then it was necessary for the applicant to elect which of those groups he wished to prosecute in the application. Ordinarily, it is a matter of division.

The Court: So you chose 2?

The Witness: So we chose 2. [145]

The Court: Fine. That is an answer.

The Witness: It is an answer.

The Court: It is an answer. Now, then, if you say now that deviation up to five per cent is within the teaching of the patent, why did you say in the same letter:

“The other references show interrupted screw threads and do not teach applicant’s arrangement of ribs which are extended at right angles to the axis of the coupling”?

The Witness: All right. They don’t.

The Court: All right. Then why didn’t you say, “at substantially right angles”? Why did you make a claim there? In other words, in this waiver you claimed the right angles as a feature which the others do not refer to. Now you say you did not mean that, that you meant “at substantially right angles,” and a deviation is an infringement of the patent.

(Testimony of R. S. Berry.)

The Witness: I would explain that in this way  
Not having made that statement myself——

The Court: In other words, you just signed the  
letter?

The Witness: That is all.

The Court: Then I am sorry. Then I will not  
ask you any questions at all, sir.

Mr. Mason: I would mention this, your  
Honor——

The Court: That is not fair. I know what I  
have in [146] mind. If you just signed what the  
other man said, that is one thing.

The Witness: Obviously, your Honor, I can't  
testify as to the reasoning of the workman here  
as to why he does a certain thing.

The Court: That isn't the point. But you signed  
the letter, and it was supposedly dictated by you.

The Witness: I think his statement was per-  
fectly correct.

The Court: No, I think I am wrong. It does  
say "CJC" dictated it.

The Witness: That is right.

The Court: I am sorry. Then I will go by what  
it says rather than an explanation, because it isn't  
fair to you to ask you what was in your mind, when  
nothing was in your mind except that you signed  
what the other man wrote.

The Witness: I approved.

Mr. Mason: Since the man is not here, I would  
like to call attention to the fact——

The Court: Let's not argue.

(Testimony of R. S. Berry.)

Mr. Mason: This isn't argument, but in the other claim it specified where it was substantially at right angles.

The Court: Where?

Mr. Mason: It is the amendment of July 3, 1947. That is it. And in the amendment to Claim 2, which became the [147] claim of the patent, it was stated.'

The Court: I know it is "substantially," but "substantially at right angles" means at right angles with possibly some error in deviation, such as is allowed, but not a deviation, not a departure as high as five per cent. That would not be substantially at right angles.

Mr. Mason: I will present my argument on that, your Honor.

The Court: All right.

Now, there was another matter that they suggested in regard to the helical angle, but so long as you did not write the answer, there is no use in asking you the question.

Let me see if you signed that letter. No, that is dictated by "CJC", too.

Then we will let it go, and it becomes a matter of discussion rather than evidence.

Mr. Mason: That is all. The plaintiff rests.

The Court: Any redirect?

Mr. Welsh: No, nothing further.

(Witness excused.)

The Court: Gentlemen, we have ample time. I do not want to shorten your time, and I think the best way is for you to come back this afternoon,

and then you will have ample time to fully argue the matter.

I had an opportunity to study the record, and the only [148] one I didn't study yesterday was the file wrapper. I am now familiar with it, as I have indicated by the questions, and I have marked some other questions which may be discussed when we argue the matter.

So we will take a recess until 2:00 o'clock.

Before we do that, Mr. Clerk, is your record complete now so far as all the exhibits are concerned?

The Clerk: Yes, your Honor.

The Court: All right.

(Whereupon, at 11:30 o'clock a.m., a recess was taken until 2:00 o'clock p.m. of the same day.) [149]

Los Angeles, Wednesday, Jan. 6, 1954, 2:00 p.m.

The Court: All right. gentlemen.

At times, after a case is concluded and before arguments begin, counsel think of odds and ends that they may wish to present, and as we have gone along very rapidly, if either side has anything further you desire to present for the record, you may do so before we begin the argument.

Mr. Mason: There is one brief matter, your Honor, on which I would like to reopen, unless I can get a stipulation, in view of Mr. Friedman's testimony just prior to the close, that he had not made any changes in his structure.

Now, during the noon recess I found a one-inch

and a half-inch device, of what he says was one of the earlier models, and the present ones which are in evidence obviously are changes. I think it pinpoints my argument here, because it shows that he originally made the ribs at a greater variation from the perpendicular.

Mr. Welsh: I don't think this is the time to argue this. If counsel wants to put it in evidence, all right.

Mr. Mason: If you have no objection, I would like to call Mr. Friedman.

Mr. Welsh: You can call Mr. Friedman.

Mr. Mason: May I reopen for that purpose, your Honor?

The Court: Yes. [150]

### SAMUEL W. FRIEDMAN

recalled as an adverse witness by the plaintiff, having been previously duly sworn, testified further as follows:

#### Direct Examination

Q. (By Mr. Mason): Mr. Friedman, I show you two devices—one, which is the one-inch-size connector, bearing the notation "MS". Is that one of your manufacture?

A. That is correct.

Q. And I show you another which bears the notation "MS", which is apparently a one-half-inch connector.

A. That is correct.

Q. And those were made by your company?

A. Yes.

Q. I show you Exhibit 18 in evidence, which is

(Testimony of Samuel W. Friedman.)

the half-inch connector which you are now manufacturing; is that not true?      A. Yes.

Q. And Exhibit 20 is the one-inch connector which you are now manufacturing; is that correct?

A. Yes.

Q. Now, you observe that some change has been made as between the two devices which I have just shown you and Exhibits 18 and 20, do you not?

A. No, there is no change basically to the connector. [151] That is what I meant. Basically we have not changed the connector.

Q. Let me ask you this: On the half-inch connector which I have in my hand, as compared to Exhibit 18, you find, do you not, that on the ribs which has not been identified in evidence as yet, it is thinner and has a lesser angle to the major axis than the device in Exhibit 18?

A. As far as I can see, they are both the same. Basically, they are both the same connector, and the angle is approximately the same.

Q. You observe also, do you not, that the unidentified connector which I have shown you, in comparison with Exhibit 20, shows thinner ribs and ribs disposed at a different angle?

A. No, I say they are approximately the same.

Mr. Welsh: You mean the angle or the thinness now?

Mr. Mason: I am speaking of the angle.

Q. You recognize they are thinner on the unidentified model than on Exhibit 20, are they not?

A. Yes.



Testimony of Samuel W. Friedman.)

Q. So that change has been made?

A. Yes, if you want to call it that.

Q. Do you know when it was made?

A. No, I would have to check back on that.

Q. Do you know when the change was made in Exhibit 18, as compared with the one-half-inch?

A. No, I do not.

Mr. Mason: May I have these marked for identification? First, the one-half-inch.

The Court: All right.

The Clerk: That is Plaintiff's Exhibit 33 for identification.

(The article referred to was marked Plaintiff's Exhibit No. 33 for identification.)

The Court: All right. Anything else?

The Clerk: Mr. Mason, are there two to be marked?

Mr. Mason: Two, yes.

The Clerk: Then this is Plaintiff's Exhibit 34, also marked for identification.

(The article referred to was marked Plaintiff's Exhibit No. 34 for identification.)

Mr. Mason: I will have to call Mr. Horton to measure, that is, to show the difference in angle, Your Honor.

That is all.

The Court: All right. Now, I want to ask Mr. Friedman one question:

You were shown an exhibit, I forget the number, in which there was no angle, but where the ridges were parallel but broken.

(Testimony of Samuel W. Friedman.)

The Witness: That was the three-eighths-inch.

The Court: And you made the statement that you never [153] sold those, that you made some samples and then distributed them to the trade, and then you say you abandoned them. I wanted you to amplify that.

The Witness: We gave those out to the trade and then, through their assistance, we made the necessary changes to improve it.

The Court: And those were just experimental?

The Witness: That is correct, sir.

The Court: At the time you did that, you knew of the plaintiff's patent, did you not?

The Witness: Yes.

Q. (By Mr. Mason): Mr. Friedman, is it not true that you actually sold some of the three-eighths-inch connectors in which the ribs were at 90 degrees?

A. No, I did not sell any of those. We did not.

Q. You know, do you not, that some of the dealers to whom you gave them as samples, as you say, did sell them?

A. We only gave them one each, so that I don't think they would have sold them.

The Court: You never gave——

The Witness: Any quantity.

The Court: ——any quantity?

The Witness: No, sir.

The Court: Have you any of those in your stock anywhere?

Testimony of Samuel W. Friedman.)

The Witness: No, sir. [154]

The Court: How many did you make?

The Witness: A hundred, or a few hundred; something like that.

The Court: And that was in what year? 1951?

The Witness: I think it was around 1951, sir. I am not sure about the date.

Q. (By Mr. Mason): Who made the changes in the angle of the ribs?

A. When you say "who," what do you mean by who'?

Q. Was it a diemaker you employed?

A. Yes, it was a diemaker.

Q. What was the name of the diemaker?

A. It was Crown City Diecasting Company.

Q. You don't know when they were made?

A. No, offhand I can't give you the exact date.

Q. And you don't know how many you disposed of prior to the change?

A. I told you approximately the 100 or 200 that were made.

Q. How do you arrive at that figure?

A. Because we called it a sample run.

Mr. Mason: That is all.

The Court: All right.

(Witness excused.)

Mr. Mason: Mr. Horton, will you come forward?

**R. J. HORTON**

recalled as a witness on behalf of the plaintiff, having been previously duly sworn, testified further as follows:

**Direct Examination**

Q. (By Mr. Mason): Mr. Horton, I show you Exhibit 33 and ask you if you have had occasion to measure the angle of the ribs on that device?

A. Yes.

Q. And to what extent, if any, do the ribs vary from the perpendicular? When I say "perpendicular," I mean perpendicular to the major axis.

A. This has a 5-degree angle.

The Court: Which connector?

The Witness: This, the ribs.

The Court: But what exhibit?

Mr. Mason: That is Exhibit 33, your Honor.

The Court: All right.

Q. (By Mr. Mason): Now, I ask you to look at Exhibit 34, and ask you if you have made the same measurements of the ribs on that device.

A. Yes.

Q. And what did you find?

A. Six degrees.

Q. That is, it varies six degrees from the perpendicular? [156] A. Yes, sir.

The Court: Is that caused by the fact that one of them is wider than the other?

The Witness: Well, it is caused by two things, your Honor. One is that he heaved up his lug in order to make it act as a straight-across.

The Court: You mean——

(Testimony of R. J. Horton.)

The Witness: The lug (indicating).

Mr. Mason: That is all I have.

The Court: Any questions?

Mr. Welsh: No, I have no questions.

The Court: All right.

Do you want to offer those exhibits now?

Mr. Mason: Yes, your Honor, I offer those in evidence.

The Court: They may be received.

The Clerk: 33 and 34 in evidence.

(The articles referred to, marked Plaintiff's Exhibits Nos. 33 and 34, respectively, were received in evidence.)

The Court: Now, gentlemen, is there anything further you want to offer before we hear the argument?

Mr. Welsh: Nothing further, your Honor.

The Court: All right. [157]

\* \* \* \* \*

[Endorsed]: Filed May 28, 1954.

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[Title of District Court and Cause.]

## ORAL OPINION

Los Angeles, Wednesday, Jan. 6, 1954, 2:00 p.m.

The Court: Gentlemen, this case has been reduced to a simple issue. I have had ample opportunity to study the prior art, which is limited, and

the file wrapper, and I have heard the oral testimony given and have seen the demonstrations.

The patent is a simple one, involving the one claim only, and I can see no reason why it cannot be decided at the present time.

I do not think there is any disagreement between us as to the principle which applies, and that is that the patent is infringed if, despite colorable deviations, the accused device shows identity of means, identity of operation, identity of result.

As you know, I am rather old-fashioned when it comes to the law of patents, and I think probably you will find that I have sustained patents and have found infringement probably more often than any judge on the Pacific Coast. In other words, I have not adopted that statement which may have attributed to the Supreme Court, but which in reality is contained only in a concurring opinion by Mr. Justice Douglas, about patentability not applying to mere gadgets.

In my career on this bench I have stated—I think it [2] was either in the Kersting case or the Mantz case—that even though an invention be humble, it is entitled to protection. And you will remember that I protected the Sundback patent, which was for the zipper, against infringement by a Japanese imitation. In order to do that, I had to take as standard a sloppy construction which worked, as against standard construction which did not work, because the history of the art showed that the zipper was made workable so that it could apply not only to rigid straight surfaces, but become flex-

ble; that instead of fitting the members in in a workmanlike manner one over the other, they were fitted in in a sloppy manner, and the man by doing a sloppy job had struck upon something that made the zipper more workable than it had been before. I am still of the opinion that it is the object of the Constitution and of Congress, in enacting the patent law, to protect an interest in all inventions, and in all my writings I have insisted that the person should be protected against the man who deliberately or fortuitously appropriates it.

In that respect we are in a different position than in the domain of copyright, where you have to show actual copying, and where we concede the possibility of spontaneous creation on the part of two persons working separately, the one not knowing about the other.

In the law of patents it does not make any difference. [3] It is priority that determines invention, and if you strike upon it without knowing what the other man did, you are still guilty of infringement, even though it were fortuitous.

However, there is also this fundamental principle to be observed, and I have written a good deal on the subject. In fact, in one case I went back, as I often do, to the history of the doctrine that where a patent is in a crowded field or is a paper patent that has not been put into actual practice, the inventor is entitled to only a narrow range of equivalent, and if there is a deviation either in the means, such as dropping one element, or in the operation, or in the result, that there is no infringement.



One advantage of having long experience in a particular field is that you meet yourself again, and when this case began I remembered another case of mine, also involving a coupling, in which I had given to a narrow invention a broad range of equivalent, only to be reversed by the Court of Appeals. That case is *Schnitzer vs. California Corrugated Culvert Co.*, 140 F.2d, 275. That case involved a pipe joint, a flexible pipe joint. I think many of you are familiar with irrigation, and that in the northern part of the state and in Oregon many a time, in order to irrigate, instead of using ditches, as we do down here, they use pipes. One of the problems they have found in using pipes is that pipe may break because of the rigidity of the joint. So a man invented [4] a flexible joint, and the California Corrugated Culvert Company imitated it in a manner which I thought constituted infringement. The action was brought by the Alien Property Custodian, because the owner of the patent was a German subject. It was brought in the name of Crowley, the then Alien Property Custodian. I tried the case in Oregon in 1942. I found there was infringement, but the case was reversed, and the opinion was written by Judge Healy, who is still on the Court, and I think the language used in that case is very appropriate here because there, again, as here, an attempt was made to give to certain language in the claims a broader meaning than it actually had. The Court of Appeals went back to the file wrapper and held that the file wrapper contained a statement wherein the inventor limited

himself to a certain means, and that, having limited himself to that, I was wrong in holding that the means used by the infringer was a substantial infringement of the device. The opinion is very brief, and I want to read it to you:

"The invention relates to conduits for conducting water for irrigation and other purposes, and specifically to the joints between the conduit pipes. The purpose of the invention, it is said, was to provide a joint sufficiently flexible to permit of the pipes' being laid over irregular ground, and readily disconnectible so as to permit [5] of the easy removal of a line of pipes from one area to another. As described in the specifications, the coupling sleeve has an internally threaded cylindrical neck screwed on the threaded end of a pipe. The other neck of the sleeve is also cylindrical but smooth so that the end of the companion pipe can be inserted through the neck 'and through the hat-shaped rubber packing,' the 'flange' of which 'is held in a recess' of the sleeve. The cup of the rubber packing fits tightly over the end of the inserted pipe, and this pipe is held fast to the sleeve by means of a hinge."

There was only one claim in suit, and that was claim No. 3. I am not going to take the trouble to read it, but then this is what the court said:

"This is a combination patent, all the elements of which are concededly old. The rubber packing, preventing leakage and permitting flexibility of the joint, is the crux or key element of the combination, Appellants argue that Lanninger's invention is

a mere aggregation of parts, and that it was anticipated. We find it unnecessary to consider the validity of the patent since we think it was not shown to be [6] infringed.

“Appellees manufactured a few sleeves, or couplings, which conform closely to claim 3 as illustrated in the drawings and specifications of the patent. One or more of these models were introduced in evidence. The ‘hat’ packing used in this model has a flange perpendicular to the axis of the sleeve, and this flange is retained in the annular groove into which it fits tightly. The parties disagree as to whether the flange is ‘clamped’ or ‘retained’ or ‘held’ in the groove, but it is clear that the packing stays in place by reason of its very shape and the shape of the recess into which it fits. This coupling was expensive to make and it was not manufactured commercially. The couplings appellees have made commercially and have successfully marketed have a rounded and relatively shallow groove, and they do not employ the hat packing. They employ instead a ‘U’ or ‘V’ shaped packing, which is the same type of packing as that used by appellants in their alleged infringing device. Appellants therefore deny that their device is an infringement upon the combination specifically claimed in the Lanninger patent.” [7]

Now, I am skipping a portion of the description and getting down to the portion of the opinion which holds that even that slight deviation was sufficient to save it from infringement. (Continuing):

“We turn once more to Lanninger’s description of his invention. Figure 1 of the drawings clearly indicates a flange packing. As already noted, the specifications describe the packing as hat-shaped, and as having a ‘flange’ which ‘is held in a recess’ of the sleeve. The specifications further state that the very strong vertical flange on the packing cup permits of a specially simple fixation as it is inserted and clamped in a groove of the coupling sleeve.’ The claim is more general, but it describes the packing as ‘having a flange frictionally retained in the groove.’ It is clear, we think, that the flange described is a vertical flange, that is, perpendicular to the axis of the sleeve, and that the phrase ‘frictionally retained’ was used advisedly without substantial reference to retention or sealing by hydraulic pressure.

“The claim is to be read in connection with the specifications.”

I am skipping a lot of references beginning with *Carnegie [8] Steel Co. vs. Cambria Iron Co.* down to *Corcoran vs. Riness*.

“Where the claim uses broader language than the specifications, reference may be had to the latter for the purpose of limiting the claim. \* \* \* The file wrapper contains evidence that the inventor understood this element of his claim in the narrower sense. During the proceedings before the Patent Office, two of the claims were rejected on *Anderson*, No. 811,812, and the inventor undertook to differentiate *Anderson*’s invention, saying: ‘*Anderson* \* \* \* does not show a packing having a flange

clamped in the sleeve.' (Anderson employed a U packing fitting into a seat similar to the one found in appellants' device.) While it is the rule in this Circuit that admissions made by the applicant to the examiner are not to be used to narrow the scope of his claim unless he has made changes in his application pursuant to the examiner's suggestions, yet the proceedings may be used to aid in construing the claim, \* \* \*

"We conclude that the allegedly infringing device employs as one of its elements a packing different from that described by Lanninger, and that the two packings do not function in the same way. Appellees attempt to minimize the differences, [9] but we think they are sufficiently substantial to spell non-infringement. Lanninger's combination is not entitled to any broad range of equivalents.

"Reversed."

Now, I think there is great similarity between what took place in that case and what took place here. We start out with an application for a patent in which nineteen claims were made, and the claims cover seven pages of typewritten manuscript. All of them were rejected and reliance was placed upon the patent's mention finally given in the references. After a long correspondence and amendment of the claims, the patent attorney finally canceled all of the claims except claims 2, 10, 11, 14, and 16. This was on July 3, 1947, over a year after the application was made. The application is dated May 10, 1946.

It is very interesting to note that in the argument which he presented as a ground for allowing the

other claims, he pointed to the fact that one of the important things in the invention is that the ribs were not convolutions because they were at right angles, and convolutions are not at right angles. This is what he said on page 2 of his letter, and this is by Mr. Berry, who was the attorney in this case. First, he signed the letter, although he did not prepare it, but, nevertheless, he was the witness who tried to defend his [10] present interpretation of the claim. This is what he says:

"The other references show interrupted screw threads and do not teach applicant's arrangement of ribs which are extended at right angles to the axis of the coupling. In other words, applicant's ribs cannot be likened to screw threads as they perform an entirely different function entirely beyond the concept of any of the references.

"Reconsideration of claims 10, 11, 14, and 16 is respectfully requested inasmuch as each of these claims define the novel ribs extending at right angles to the axis of the sleeve a distance less than one-half of the circumference of the sleeve. This feature is not shown nor suggested by any of the references. As pointed out the secondary references merely show interrupted screw threads and applicant's ribs cannot be likened to such screw threads.

"Applicant elects to prosecute claims drawn to the invention as shown in Fig. 2, in the event no generic claims are allowed."

And, of course, all of his generic claims have been rejected. Then the examiner came back and



again rejected them, and also stated that the interrupted thread would not show invention. [11]

Six more months passed, and then under date of November 10, 1948, claims 2 and 10 were retained in the case, the only change made in the original claim 2 being the words "ribs extending substantially at right angles to the major axis of said tubular member."

Now, remember, the letter in which the right angle feature was insisted upon is the same letter in which this change was made, adding these words, so that it cannot be argued that the substantiality had a different meaning, because while he makes this suggestion, he keeps insisting that it was the right angular position which distinguished the patented invention from the prior art.

Once more all the claims were rejected. In fact, they are noted as canceled, and they say that No. 2 appears allowable, and then argue about 10, and the attitude remained unchanged.

Now, in answer to this another letter was written six months later, on November 10th, also signed by Mr. Berry, in which he insists that claim 10 should be allowed, because claim 10 defines a spiral having a greater helical angle than the normal helical angle of the convolutions of the conduit, and for that reason is distinguishable.

Evidently, the examiner was getting tired of the correspondence, and he finally wrote a letter in which he said that this is the end, either you take 2, or no more [12] amendments will be accepted,



and as of May 10, 1946 he rejects 10, marks 2 as ready to be allowed, and states this:

“\* \* \* The modified device of Hunter is considered the full equivalent of that device claimed by applicant in that any difference that may exist between the differential helical angle is deemed no more than a mere matter of choice, design, or expediency. Furthermore, the stretching action set forth by applicant is held to find its full equivalent in the stretching action of Hunter.

“As a clear issue has been reached, this action is made FINAL.”

The “final” is spelled out in capital letters, which means no further amendments will be considered.

Then we find a letter from Mr. Berry, and it shows that claims 7 and 10 have been canceled, and the patent is allowed to issue on the allowed claim which had been requested.

Now, this correspondence shows that the plaintiff here started out with an invention for which he claimed great originality, and ended up with a single claim out of nineteen, and with a statement on his part that if no generic claims are allowed—which were not allowed—that he wanted to prosecute the claim drawn to the invention as shown in Fig. 2.

Now, the invention, as shown in Fig. 2, as I pointed out [13] to you before and pointed out to Mr. Berry, shows clearly that these ribs are at right angles, and in order to show that they were at right angles the figure and the drawings which are attached to the application, and as they were recopied

into the patent, show a dotted line being drawn crosswise from the bottom of one of the ribs to the other, to show the perpendicular character of the rib, and Figure 8 shows the way it works in engaging the conduit, because it is so arranged.

Repeatedly in these cases we have situations where the inventor, although having abandoned a claim, or having been refused claims in the Patent Office and having been limited to a very narrow claim, tries to recapture them.

I have had these cases before me repeatedly, and one of the most interesting cases I have had is that of *Joyce, Inc. vs. Solnit*. *Joyce, Inc.* is the shoe company. That case involved the *Joyce shoes* which I myself wear in the summertime. But platform shoes have been known for centuries. They appeared not only in the prior art, but appeared as having been used in costumes, and are notoriously present in the manner in costumes of the Chinese.

*Solnit* and others began the manufacturing of platform shoes, but instead of containing one enclosed sole, they contained an ordinary sole, and merely raised them at the heel by having round members. It was argued that it was an infringement of the patent. I held that it was not. By the [14] way, you appeared for the defendants in that case, Mr. Mason, or, rather, Mr. Graham did. This is what I said:

"If we interpret the midsole member to include any wedge-type heel raising device, in a shoe construction, the invention would be invalid for anticipation. Novelty alone is not invention. \* \* \* The art

s very old. There are in evidence wedge-type shoes long ante-dating the plaintiff's invention. Wedge-type shoe construction dating centuries back appears in art works and works on costume design. The fact that some of them relate to 'slippers' does not call for a different conclusion. Plaintiff's original application called for a 'slipper.' There would be no invention in applying to shoes for street wear the art heretofore applied to house slippers. They are branches of the same art,—the art of shoe-making."

So I found the claims limited to the structure actually described in the claims and illustrated by the specifications, valid, but not infringed.

Now, in that case there were palpable imitations of the shoe and the appearance, but there was no attempt at that time to bring in unfair competition. Later on I think there was a follow-up of this case, and I eliminated some shoes because they had imitated the color and the other devices used by [15] Joyce.

Now, in the Mantz case, that is, Mantz vs. Kersting, 29 Fed. Supp. 706, that again involved a simple patent. That is the case in which I used the expression that an invention may be humble and yet be entitled to protection. This is on page 712:

"Counsel for plaintiffs concedes that it is a 'humble' invention. Humility or simplicity does not, necessarily, mean lack of invention."

I think that the record in this case shows the manufacture by the defendant of a limited number of samples which could be said to conform to the

teachings of the plaintiff's patent. However, the uncontradicted evidence in the record is that they were not for sale. They were not sold. They were merely samples distributed to a few customers, and were abandoned thereafter, and none of them have ever been made since that time.

So, this being an equity case, we have to take the case as it exists at the time, and even if it were conceded that manufacturing them, threatening for sale, and offering for sale, might entitle the inventor to an injunction to prevent the possible carrying of the scheme into effect, nevertheless, I am satisfied from the state of the record that there is no evidence that any of them are in the field of trade; that they were made as samples and were given out as samples in lots [16] of one to a customer, and that those that are in actual use are the devices which have been introduced here, and which show that the means used by the device of the defendant are entirely different.

To go back for a moment, by way of summing up, to the single claim, it says:

"In a coupling for spirally-wound, flexible conduits, a tubular member having means at one end adapted to be affixed to the wall of a junction box or the like, the other end of said coupling being insertable within the end of a conduit, and having a series of ribs extending substantially at right angles to the major axis of said tubular member and adapted to engage the convolutions of the conduit, said ribs being sequentially disposed in staggered relation along the outer surface of the con-

duit-engaging portion of said coupling so as to define a spiral having a greater helical angle than the normal helical angle of the convolutions of the conduit."

Now, since this claim was allowed, the portion of it relating to the coupling, while not abandoned, is not being manufactured, the object being to secure the full advantage for the coupling, regardless of its adaptation to a box. I should have said that the adaptation to a junction box has been [17] practically discarded, and the emphasis is placed upon a coupling to be used wherever a coupling is necessary, and the two elements are the ribs extending at right angles to the major axis, and the ribs being so disposed in staggered relation that they define a spiral having a greater helical angle than the normal helical angle, which means, of course, they are spaced farther apart than are ordinary spaced convolutions of a conduit.

Now, it is quite evident to me that right angle means right angle, and that the inventor so exemplified his invention, and when pinned down by the Patent Office to designate the embodiment of the invention, he says that he chooses as the embodiment Figure 2, which clearly shows a right angle. I think the word "substantially" at right angles modifies the words "right angles" very much, and is intended to take care of such tolerances as may be allowed in the construction of devices which are not in the realm of precision devices and the construction of precision instruments. I think a coupling which contains these broken convolutions

at a five or six-degree angle is an entirely different means. I am also of the view, by examining the tubing after it had been applied, that it does show a pressure at different places when the accused device is applied than when the patented device is applied. The accused device exercises an outward pressure, while the patented device achieves a locking by a [18] stretching and a spreading of the convolution.

I think the result is difficult to determine, because ultimately all that is achieved is to lock it in place, and the demonstrations made by the plaintiff himself, one of the inventors, show that even the prior art resulted in a locking, because when he used it on the same types of tubing, which he brought for use with his own device, a locking process resulted. Whether it is tighter or looser cannot be determined, because I think the mere fact that when it was applied it could not be applied by hand, but had to be removed by the use of pliers, in itself does not demonstrate any appreciable difference in the results. So we find that clearly one of the means used by the accused device differs from the others, and because it is an angle it operates in a different manner. Whether it locks more tightly and can be removed more easily, I think is immaterial, because the law of equivalents does not require that there be deviation in all respects. If one of the elements is a substantial deviation, denoting invention, there is no infringement.

We have a case where the plaintiff himself in the course of the proceedings in the Patent Office



has accepted a single claim, which he said is exemplified by a figure which clearly shows ridges or ribs at right angles, and the accused devices now in commerce and manufactured by the defendants are at an angle and operate in a different manner, because the pressure [19] is applied differently, and under the teachings of the Schnitzer case, where you are dealing with a combination old in the art, that in itself is sufficient. The court in that case said that the infringing device, nevertheless, "employs as one of its elements a packing different from that described by Lanninger, and that the two packings do not function in the same way."

The result, of course, is the same, because there we had a flexible joint. It is quite evident to me that I was so much impressed by the fact that they functioned in the same manner and that the result achieved was the same that I felt that there was infringement.

I did not write an opinion at the time. However, even if I were to feel, as I sometimes do, that I am still right despite what the Court of Appeals did to the case, nevertheless, I would have to follow the teachings which they lay down, and that is that when we are dealing with the claims in a crowded field that have been delimited by the Patent Office, with the acquiescence of the plaintiff, to a particular structure, you cannot find infringement by applying it to other structures, in which at least one of the elements is different and which does not function in the same manner.

Gentlemen, I have indicated the grounds for my



opinion, and judgment, therefore, will be for the defendant. I will not allow costs to the defendant, and I will not allow attorneys' [20] fees.

Mr. Welsh: May we have twenty days to submit findings?

The Court: Yes. You may prepare findings, and you may submit them to the other side, and they may have five days in which to offer any objections they desire.

Thank you, gentlemen, for the manner in which you presented the case. I will return these to you. I do not think I need it, and it merely encumbers my file. There is one in the file, which is sufficient.

[Endorsed]: Filed June 16, 1954.

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[Endorsed]: No. 14399. United States Court of Appeals for the Ninth Circuit. D & H Electric Company, a corporation, Appellant, vs. M. Stephens Mfg., Inc., a corporation, and Jack McLoughlin, doing business as McLoughlin Sales, Appellees. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed: June 21, 1954.

/s/ PAUL P. O'BRIEN,  
Clerk of the United States Court of Appeals for  
the Ninth Circuit.

In the United States Court of Appeals  
for the Ninth Circuit

No. 14399

D & H ELECTRIC COMPANY, a corporation,  
Plaintiff-Appellant,  
vs.

M. STEPHENS MFG., INC., a corporation;  
JACK McLOUGHLIN, doing business as Mc-  
LOUGHLIN SALES; DOE ONE; et al.,  
Defendants-Appellees.

## APPELLANT'S STATEMENT OF POINTS

Appellant will rely upon the following points on appeal:

1. The trial court erred in holding that defendants were not guilty of infringing United States Letters Patent in suit 2,475,322, and in holding that plaintiff is not entitled to an accounting of damages.

2. The trial court erred in refusing to restrain defendants from infringing United States Letters Patent in suit No. 2,475,322.

3. The trial court erred in finding, concluding and holding that prior patents Adamson 1,494,524; Wilson 1,629,058, Jacobi 1,973,170, and British Patent 22,310 anticipate the claim of the patent in suit, except for the arrangement of the ribs of the patent in suit substantially at right angles to the major axis of the tubular portion of the patented combination.

4. The trial court erred in finding, concluding

and holding that defendants avoided infringement of the patent in suit by making the angularity of the ribs of the accused device from  $85^{\circ}$  to  $89^{\circ}$  to the major axis of the tubular portion of said device instead of making them precisely at right angles ( $90^{\circ}$ ) to said axis.

5. The trial court erred in finding, concluding and holding that, by file wrapper estoppel or otherwise, the patentees of the patent in suit have so limited the patent claim that the accused device does not infringe.

6. The trial court erred in finding, concluding and holding that the accused device functions in a manner materially different from the manner in which the patented device functions.

7. The trial court erred in finding, concluding and holding that the clause "ribs extending substantially at right angles ( $90^{\circ}$ ) to the major axis of said tubular member", as used in the claim of the patent in suit must be so construed that it cannot embrace a construction wherein the ribs are disposed at an angle of from  $85^{\circ}$  to  $89^{\circ}$  to said major axis.

Dated this 23rd day of June, 1954.

MASON & GRAHAM,

/s/ By COLLINS MASON,

Attorneys for Plaintiff-Appellant

Acknowledgment of Service attached.

[Endorsed]: Filed June 24, 1954. Paul P. O'Brien,  
Clerk.

[Title of U. S. Court of Appeals and Cause.]

## APPELLANT'S DESIGNATION OF RECORD

The plaintiff-appellant hereby designates the following identified portions of the record which it deems necessary for consideration of the appeal:

1. Complaint, filed November 17, 1952;
2. Answer and Counterclaim, filed May 28, 1953;
3. Answer to Counterclaim, filed June 1, 1953;
4. The following portions of reporter's transcript: Page 4, lines 1 to 23, inclusive; commencing at page 10, line 13, to and including page 107, line 19; commencing at page 110, line 1, to and including page 157, line 22;
5. The following portions of reporter's separate transcript of proceedings on January 6, 1954, containing opinion delivered orally by the Court, commencing at page 2, line 1, and continuing to page 21, last line, inclusive;
6. Plaintiff's exhibits 1 to 34, inclusive;
7. Defendants' exhibits A to D, inclusive;
8. Findings of Fact and Conclusions of Law, filed March 9, 1954;
9. Final Judgment entered March 9, 1954, filed March 9, 1954;
10. Notice of Appeal;
11. Cost Bond on Appeal;

12. Order Extending Time to Docket Appeal;
13. Concise Statement of Points on Appeal;
14. Stipulation and Order Extending Time to Docket Appeal;
15. Designation of Portions of Record, Proceedings, and Evidence to be Contained in the Record on Appeal (DC);
16. This Designation.

The Clerk of this Court is requested to include in the printed record on appeal the following items above specified: 1, 2, 3, 4, 5, 8, 9, 10, 11, 12, 13, 14, 15 and 16.

The Clerk of this Court is also requested to prepare ten (10) copies of a book of exhibits, which shall constitute a part of the printed record on appeal, to include the following exhibits: 1, 25, 26, 27, 28.

The remainder of the exhibits are to be treated and handled as physical exhibits.

Dated at Los Angeles, California, this 23rd day of June, 1954.

MASON & GRAHAM,  
/s/ By COLLINS MASON,  
Attorneys for Plaintiff-Appellant

Acknowledgment of Service attached.

[Endorsed]: Filed June 24, 1954. Paul P. O'Brien,  
Clerk.